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IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1903

No. 42

Office Supreme Court U. S.
FILED
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JAMES H. McKENNEY,
Clerk.

WILLIAM R. WARNER, JR., Executor of the Estate of William R. Warner, Deceased,
Appellant.

vs.

THE SEARLE AND HERETH COMPANY, GIDEON D. SEARLE, FRANK S. HERETH AND O. T. EASTMAN.
Appellees.

On Appeal from the United States Circuit Court of Appeals, for the Seventh Circuit.

Brief for Appellees on Motion to Dismiss Appeal and on the Merits.

PHILIP C. DYRENFORTH,
Counsel for Appellees.

Geo. Hornstein Co., Printers, Chicago.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1902.

No. 307

WILLIAM R. WARNER, JR., Executor of the Estate of William R. Warner, Deceased,
Appellant.

vs.

THE SEARLE AND HERETH COMPANY, GIDEON D. SEARLE, FRANK S. HERETH AND O. T. EASTMAN.
Appellees.

On Appeal from the United States Circuit Court of Appeals, for the Seventh Circuit.

Brief for Appellees on Motion to Dismiss Appeal and on the Merits.

NOTICE OF MOTION TO DISMISS APPEAL.

Messrs. Frank T. Brown and Samuel E. Darby, Counsel for Appellant:

GENTLEMEN:—Please take notice that on Monday, the 27th day of April, 1903, I shall appear before the Supreme Court of the United States, and at the opening of court on

said day, or as soon thereafter as counsel can be heard, I shall present to the court a motion to dismiss the above-entitled appeal upon the ground that said court is without jurisdiction to hear and determine said appeal.

A copy of said motion is herewith furnished you, and also, in compliance with the rule of the Supreme Court prescribing the mode of procedure for a motion of this nature, a copy of the brief of argument to be submitted with the said motion in support thereof.

PHILIP C. DYRENFORTH,
Counsel for Appellees.

Service of the above notice, together with a copy of the motion and a copy of the brief therein referred to, is acknowledged this 6th day of April, 1903.

FRANK T. BROWN,
SAMUEL E. DARBY,
Counsel for Appellant.

MOTION TO DISMISS APPEAL.

Now come the appellees, The Searle & Hereth Company, Gideon D. Searle, Frank S. Hereth and O. T. Eastman, by their counsel, Philip C. Dyrenforth, and move that the above-entitled appeal be dismissed upon the ground that this court is without jurisdiction to entertain the same for the reason that the jurisdiction of the United States Circuit Court in said cause was dependent entirely upon the opposite parties to the suit or controversy, being citizens of different states, whereby the judgment or decree of the Circuit Court of Appeals for the Seventh Circuit herein was final under the provisions of Section 6 of the Appellate Courts Act of March 3, 1891.

PHILIP C. DYRENFORTH,
Counsel for Appellees.

Chicago, April 6, 1903.

The above motion was duly submitted on briefs, but was passed by the court for oral argument. Accordingly the first part of what follows is a brief on the motion to dismiss and the second part a brief on the merits.

BRIEF ON MOTION TO DISMISS APPEAL.

May it please the Court:

The motion herewith presented to dismiss the above-entitled appeal is based on the first paragraph of Section 6 of the Appellate Courts Act of March 3, 1891, particularly that portion which defines the cases in which the judgments and decrees of the Circuit Courts of Appeals shall be final.

The paragraph referred to, with the portions pertinent to this motion italicized, is as follows:

> "Sec. 6. That the Circuit Courts of Appeals established by this Act shall exercise appellate jurisdiction to review by appeal or writ of error final decisions in the District Courts and the existing Circuit Courts in all cases other than those provided for in the preceding Section of this Act, unless otherwise provided by law, *and the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy being* aliens and citizens of the United States, or *citizens of different states;* also in all cases arising under the patent laws, under the revenue laws, and under the criminal laws and in admiralty cases."

The bill of complaint, filed in the United States Circuit Court for the Northern District of Illinois, Northern Division, charged infringement of an alleged trade-mark in the word "Pancreopepsine" applied to a medicinal preparation

designed for use in digestive disorders. It contains the well-known remedies, pancreatin and pepsin. (R., p. 35.) The defendants make and sell a preparation for the same purpose which they call "Pancro-Pepsin," pancreatin and pepsin being the predominant medicinal ingredients. The Circuit Court on final hearing entered a decree in favor of the complainant for an injunction and accounting. In the opinion (R., p. 200), the court held that, aside from the similarity of the designations, unfair competition was not established. Within thirty days an appeal from the order of the Circuit Court granting the injunction was taken to the Circuit Court of Appeals, and the decree of the Circuit Court was there reversed and the bill ordered dismissed (R., p. 207). An appeal to this court was allowed on an *ex parte* application by counsel for appellee in the Circuit Court of Appeals, but a motion to stay the mandate during the pendency of the appeal to the United States Supreme Court was overruled. (R., p. 214.)

An examination of the record will show that, though a registered trade-mark is mentioned in the bill of complaint and in the testimony, there is nothing whatever, either in the pleadings or proofs, which makes it a factor in the case, unless it be as an aid in establishing the date of adoption. There is no definite allegation and no showing that the complainant, William R. Warner, ever used the alleged trade-mark in commerce with a foreign nation or an Indian tribe since the year 1882, just prior to the registration, when two consignments were made to Australia, seemingly as a mere basis for the registration.

There is no allegation and no showing that the defendants, or either of them, ever used the designation complained of in commerce either with a foreign nation or with an Indian tribe, or applied it to goods intended for such commerce.

All the allegations of the bill referring to the right of the

complainant, and all the proofs in that behalf, are pertinent to a suit for infringement of a common law trade-mark.

An examination of the bill of complaint alone makes it obvious that there could be no federal jurisdiction in this cause if the opposite parties had been citizens of the same state, and hence such jurisdiction was dependent ENTIRELY *upon the opposite parties being citizens of different states.*

THE PLEADINGS.

1. *This court is without appellate jurisdiction of this cause on the face of the pleadings.*

The bill of complaint recites that the trade-mark "Pancreopepsine" was registered by the complainant in the United States Patent Office December 26, 1882, and a copy of the certificate, No. 9911, is annexed to the bill; but the bill nowhere charges that the defendants have infringed the complainant's rights under the registered trade-mark, *because there is no allegation in the bill that the defendants have used their alleged infringing designation in commerce with any foreign nation or with any Indian tribe.* The only allegation of infringement is that the defendants have sold their medicinal preparations with the alleged infringing designation "in the Northern District of Illinois, and elsewhere." (R., p. 4.) The bill further alleges that the public in general, and particularly the citizens of the Northern District of Illinois, associate the name with the complainant's medicinal preparation and that the defendants' designation is a fraud and deception upon such of the citizens of the Northern District of Illinois, and elsewhere, as purchase the defendants' product believing it to be the complainant's, and that the public generally, and particularly

the citizens of the Northern District of Illinois, are damaged and misled (R., p. 5). The bill alleges that the complainant, prior to the commencement of his suit, had sold large quantities of his medicinal preparation provided with his alleged trade-mark throughout the United States and in commerce with foreign countries, and particularly in the cities of Philadelphia and Chicago (R., p. 2); but if the allegation as to commerce with foreign countries is intended to imply that large quantities had been sold in foreign countries, it is not supported by the testimony, as will be shown later. However, the allegation would obviously be satisfied by the sale of one bottle of the preparation in each of two foreign countries and all the rest in the United States.

On the other hand, the bill of complaint, as amended by leave of court at the final hearing to allege the statutory amount in controversy (R., p. 182), and as further amended by stipulation to make it state definitely the diverse *citizenship* of the parties (R., p. 201-2), contains all allegations requisite to support a bill for infringement of a common law trade-mark and give Federal jurisdiction by reason of diverse citizenship.

It is plain from the language of the statute above quoted, and from decisions of this court, that the word *"entirely"* is of controlling importance.

American Sugar Refining Co. v. *New Orleans,* 181 U. S., 275;

Union Pacific Railway Co. v. *Harris,* 158 U. S., 326;

Howard v. *Stewart,* 184 U. S., 754;

Press Publishing Co. v. *Monroe,* 164 U. S., 105;

Ex parte Chas. F. Jones, 164 U. S., 691;

Northern Pacific Co. v. *Amato,* 144 U. S., 465;

Sonnentheil v. *Christian Moerlein Co.,* 172 U. S., 401;

Third Street & Suburban Railway Co. v. *Lewis*, 173 U. S., 458;
The Colo. Cent. Consol. Mining Co. v. *Turck*, 150 U. S., 137;
Borgmeyer v. *Idler*, 159 U. S., 407;
Benjamin v. *New Orleans*, 169 U. S., 161.

It is submitted, however, that the mere recital in the bill of complaint of the fact of registration of a trade-mark in the Patent Office, unaccompanied by any allegation that the supposed rights of the complainant under the registered trade-mark to exclusive use in lawful commerce with foreign nations and Indian tribes have been invaded by the defendant, can not serve to force appellate jurisdiction upon the United States Supreme Court. An allegation of registration, where registration has been had, is a pertinent and material fact to be alleged in every bill of complaint for infringement of a common law trade-mark, whether brought in a State court or in a Federal court, since the certificate of registration is an important matter of evidence, at least on the subject of the date of adoption. In the present case the allegation that the complainant, William R. Warner, had registered his trade-mark "Pancreopepsine" on the 26th day of December, 1882, was entirely proper as referring to a matter of record evidence to show an early date of adoption, but beyond this, in view of the other allegations in the bill of complaint, it had no effect whatever. The bill of complaint, in order to be sustained for infringement of a registered trade-mark, must allege infringement of a registered trade-mark by interference on the part of the defendant with the rights secured to the complainant by the registered trade-mark, and these rights are expressly limited to commerce with foreign nations and with the Indian tribes. This

question was before this court in the case of *Ryder* v. *Holt*, 128 U. S., 525, where the court said:

> "But it is now assigned for error that, as defendant and complainants below were citizens of the same State, and the bill did not allege that the trade-mark in controversy was 'used on goods intended to be transported to a foreign country' (A. March 3, 1881, Chap. 138, Sec. 11; 21 Stat. at L. 502), the Circuit Court had no jurisdiction, and the decree must be reversed for that reason."

The above decision goes no farther than the exigencies of the case demanded, and follows literally the language of Section 11 of the Act. Two sections of the Act, viz., Sections 7 and 11, relate to Federal jurisdiction, and in order that they may be understood they must be considered together and in the light of the origin and plain intent of the entire Act. Section 7 with the relevant part italicized is as follows:

> "Sec. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; *and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.*"

Section 11, with the relevant part italicized, is as follows:

> "Sec. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; *nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.*"

Neither section is explicit as to whether the *use* referred to is intended to signify use by the complainant or use by the defendant; but it is presumably the latter, unless use by the complainant *at the time of bringing the suit* is meant, which, though unlikely, is perhaps not impossible, since the expression is in the present tense, and further since use by the registrant in commerce with foreign nations or with Indian tribes must have existed at some time prior to registration as a prerequisite thereto, and hence is implied by the registration itself, so that it does not seem reasonable to suppose *that* use to be the one referred to in the conditional clause of Sec. 11. Either interpretation would be fatal to jurisdiction in the present case by virtue of the registration, because there is nothing to show that the complainant was using the designation in foreign commerce at the time the bill was filed (February, 1898), or had used it in such commerce within sixteen years prior to that time, and there is nothing to show that the defendants used it at any time in such commerce. It is especially evident that in Sec. 11 the language "*unless the trade-mark in controversy is used on goods intended to be transported to a foreign country*," etc., refers to such use by the defendant. That is to say, it is evident that the language was intended to recognize the fact that Federal jurisdiction could always attach

under allegations of diverse citizenship and the statutory amount, but that in the absence of these conditions it could attach only under an allegation of interference by the defendant with the complainant's commerce with foreign nations or Indian tribes. This interpretation makes Sec. 11 entirely consistent with the closing part of Sec. 7, viz., "and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy," *i. e.,* cases wherein the defendant infringes the trade-mark in commerce with foreign nations or Indian tribes.

The constitutionality of the Trade-Mark Act of March 3, 1881, has never been drawn in question at any stage of this case, nor is it drawn in question now, the assertions in appellant's brief (pp. 3, 27, 28, and elsewhere) to the contrary notwithstanding. The constitutionality has been seriously questioned by the Circuit Court of Appeals for the Seventh Circuit (*Illinois Watch Case Co.* v. *Elgin National Watch Co.,* 84 Fed. Rep., 667); but it is enough for the present motion to say that it seems plain from the history and logic of the Act that the only ground upon which its constitutionality can be upheld (if at all, which is not argued here), is that it is strictly limited in its intent and scope to lawful commerce with foreign nations and with Indian tribes, and that no infringement of a registered trade-mark can occur except by interference with that commerce. This construction has been repeatedly given to the Act by the Circuit Courts of the country, and also by the Circuit Court of Appeals for the Seventh Circuit, as shown by the excerpts from verious decisions given below. Where the Federal court has jurisdiction of the subject matter in this way, it of course has jurisdiction of the parties, whether they are citizens of the same State or of different States, and this without regard to the amount in controversy.

Being based upon the commerce clause of the Constitution, the Act of 1881 might have included commerce among the several States as well as commerce with foreign nations and Indian tribes. In fact, as the bill was originally introduced, it included commerce among the several States. This is stated in Brown on Trade-Marks, 2nd edition, Sec. 285, p. 294, as follows:

> "The bill when introduced in the House of Representatives used the exact words of the third paragraph of the eighth section of the first article of the Constitution. The sub-committee having it in charge, partly through a misconception of the ruling of the Supreme Court, as is manifested by their report, and partly through a fear, which at the time had seized possession of some minds, as to national legislation having a tendency to interfere with the reserved rights of individual States, struck out the words 'and among the several States.' To insist upon a restoration of these words at that time must have jeopardized the passage of the bill. The Senate would have corrected the error, but the slightest amendment must have inevitably defeated final action, as the term of Congress was near its expiration."

In a note to this section, the author says:

> "Of course, all persons will understand that this limitation does not affect common law rights, although it excludes mere inter-state trade-marks from registration."

Moreover, all common-law rights are expressly preserved by Sec. 10 of the Act.

The portions of the statute to which the above quotations from Brown on Trade-Marks relate are in the preamble, as follows:

> "That owners of trade-marks *used in commerce with foreign nations or with the Indian tribes*, provid-

> ed such owners shall be domiciled in the United States, or located in any foreign country, or tribes, which by treaty, convention, or law, afford similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying," etc.

and in the 2nd, 3rd, 7th and 11th sections of the Act. The language in Sec. 3 is as follows:

> "But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned." * * *

The Act is indefinite in certain particulars, and is much in need of construction by this court, in order that its scope and meaning may be definitely and finally determined. It is, however, susceptible of a very simple and clear interpretation, if it is conceded to have its metes and bounds in commerce with foreign nations and Indian tribes. Confusion arises only when an attempt is made to expand its scope beyond this. An opportunity to have the Act construed by the United States Circuit Court of Appeals for the Seventh Circuit was narrowly lost in the case of *Aaron B. Wrisley* v. *The Geo. E. Rouse Soap Co. et al.*, 90 Fed. Rep., 5, where the court, by Judge Jenkins, said:

> "We need not determine whether, by virtue of the statute of the United States (21 Stat., 502), a trade-mark registered thereunder can be protected by a court of the United States as a right arising under the laws of the United States, in the absence of diverse citizenship of the parties; nor need we determine whether, assuming such right of jurisdiction, the relief in case of infringement shall be limited to the protection of the right in the use of the trade-mark upon goods intended to be transported to a foreign country, or in

> lawful commerce or intercourse with an Indian tribe, since no case is made here which would justify us in now passing upon these questions."

However, the same court has since held (in the *Elgin Watch* case) and, as stated in an earlier part of this brief, other courts have held, that the trade-mark statute of 1881 applies only to the use of the trade-mark in commerce with foreign nations and Indian tribes and is not pertinent where the charge of infringement is confined to domestic use of the trade-mark, which seems to be the proper and rational interpretation, having due regard to the constitutional limitation which underlies the statute, and which is expressed in the *Trade-Mark Cases*, 100 U. S., 82. Indeed, in the light of the decision last mentioned, out of which the statute under consideration grew, it is difficult to imagine upon what theory the constitutionality of the Act can be maintained unless it is limited in the manner expressed in the excerpts from decisions given below.

In *Illinois Watch Case Co.* v. *Elgin National Watch Co.*, 94 Fed. Rep., 667, the Circuit Court of Appeals for the Seventh Circuit said (see p. 672):

> "If it were allowable to us to assume jurisdiction to grant equitable relief upon the ground of fraud, if the bill were aptly framed to that end, *the relief could only extend in restraint of the wrong, so far as it affected foreign commerce and commerce with the Indian tribes.*"

The Supreme Court, in reviewing the same case (179 U. S., 665) did not touch upon this point.

In *Schumacher* v. *Schwencke et al.*, 26 Fed. Rep., 818, Judge Wheeler said:

> "It is alleged that the orator, a corporation, has used this trade-mark on labels in domestic commerce, inter-

state commerce, and commerce with foreign countries, and that the defendants have in New York applied it to labels not made or sold by or for the orator, and sold the same, and have sold the same in other States of the United States, 'and have sold the same in foreign countries.' These are all the allegations there are as to the use of the trade-mark by the defendants in foreign commerce, and all such sales and use are denied by the defendants. There is nothing in the case about use of it in commerce with any Indian tribe. The courts of the United States have no jurisdiction of suits like this unless it is given by statute under which the trade-mark was registered. (*Trade-Mark Cases,* 100 U. S., 82; *Luyties* v. *Hollender,* 21 Fed. Rep., 281; 21 St. at Large, 504, Chap. 128, Sec. 11.) That statute limits the jurisdiction under it so that it is not conferred *'unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.'* It seems to be understood by the orator's counsel that jurisdiction is given if the trade-mark is used by the orator in foreign commerce, or upon goods intended to be transported to a foreign country. But the authority of Congress over this subject arises from the power to regulate commerce, and does not extend to the protection of trade-marks within a State. (*Trade-Mark Cases,* 100 U. S., 82.) The orator may have a valid trade-mark and an exclusive right to its use in New York; but, if so, his rights in that respect do not rest upon the laws of the United States. *The registration under the statute only confers a right to it in foreign commerce, and a claim for infringement, or to be protected against infringement, can not arise under the constitution or laws of the United States unless the infringement is upon the right to use it in foreign commerce, which can only be by using the trade-mark without right in such commerce.* The jurisdiction is not conferred at all by express words of the statute; but only by providing a mode of acquiring a right, a suit for the invasion of which would arise under the laws of

the United States within the Act of 1875. The clause quoted from is restrictive of that jurisdiction. *The defendants do not infringe upon any right resting upon the laws of the United States unless they use a trade-mark in foreign commerce, and jurisdiction of a suit for such infringement is not left in the courts of the United States unless such infringement consists in using the trade-mark by the defendants upon goods intended to be transported to a foreign country.* The bill falls short of alleging such use; and this court appears to be without jurisdiction to restrain the use which is alleged."

In *Prince's Metallic Paint Co.* v. *Prince Mfg. Co. et al.*, 53 Fed. Rep., 493, Judge Butler said:

"Have we jurisdiction? The plaintiff and the principal defendant are citizens of Pennsylvania. To give us jurisdiction it must therefore appear that a federal cause of action is set out. The breach of a common-law trade-mark is not such a cause. *While registration is averred, there is no charge of infringing the plaintiff's rights under it. Such registration protects the use of the mark in foreign commerce and with Indian tribes; nothing more.* It would seem therefore to follow very plainly that the facts necessary to confer jurisdiction are not averred. The bill is drawn precisely as if for trial in the State courts; and presents a proper cause of action for these tribunals. It seems to have been supposed that we can redress injuries resulting from trespass on the plaintiff's common-law rights. That we can not is clear, we think, on principle, and has been so decided. (*Schumacher* v. *Schwencke*, 26 Fed. Rep., 818.) Indeed the facts seem to be admitted in the plaintiff's brief at page 4."

In *Glen Cove Mfg. Co.* v. *Ludeling*, 22 Fed. Rep., 823, Judge Wallace said:

"But both parties are citizens of this State, and the jurisdiction invoked is, therefore, founded solely on

the act of Congress for the protection of trade-marks and can only be exercised according to the statute which invests the court with authority to hear the controversy. The complainant is here upon his statutory title to enforce his statutory rights in the enjoyment of his trade-marks, and the single question is, therefore, whether these have been invaded. If the defendant has appropriated either of these trade-marks, the complainant, as the party aggrieved, by the language of the Act (Sec. 7) 'shall have his remedy according to the cause of equity to enjoin the wrongful use of such trade-mark.' * * * Unless the complainant's trade-mark is used on goods intended to be transported to a foreign country, by the terms of the act of Congress the court can take no cognizance of the wrong in a suit between citizens of the same State. Sec. 11."

In *Gravely* v. *Gravely*, 42 Fed. Rep., 265, Judge Bond said:

"This is a bill filed to enjoin the defendants from using the trade-mark of the complainants, which had been duly registered under the Act of March 3, 1881. The parties to these proceedings are all citizens and residents of Virginia, so that whatever jurisdiction the court may have to entertain the bill arises not from the citizenship of the parties, but from the fact that the complainants have a right guaranteed to them by act of Congress, which right is the exclusive use of their registered trade-marks against the claims of all other persons to use the same. If it be admitted that the complainants are entitled to the exclusive use of the trade-marks mentioned in the bill otherwise than by act of Congress, a matter which, in our view of the case, it is not necessary to determine, and that the defendants have used them upon tobacco of their manufacture without the consent of the complainants, they do not derive that right of exclusive use from any statute of the United States. *Their right under the laws of the United States is the right to use these registered trade-marks in foreign commerce.* Act March 3, 1881

(U. S. St. at L., 502.) *The bill in this case nowhere asserts that the defendants have used these registered trade-marks in foreign commerce, nor does the proof show a single instance of such use on their part.* Under these circumstances, since the parties to the suit are citizens of the same State, *and since the only right guaranteed to complainants by the laws of the United States is the right to use exclusively their registered trade-marks in foreign commerce, which right it is not alleged the defendants have infringed,* it seems the court is without jurisdiction in the matter. The complainants may be entitled to the exclusive use of these registered trade-marks at common law, or under some State statute, and, if they were citizens of different States, might possibly file this bill here; but, under the state of facts above set forth, we think the bill must be dismissed for want of jurisdiction, and it is so ordered."

In *Luyties* v. *Hollender,* 21 Fed. Rep., 281, Judge Wheeler said:

"Rights and remedies pertaining to trade-marks generally depend upon the laws of the State, common and statutory, and not upon the laws of the United States. (*Trade-Mark Cases,* 100 U. S.) The laws of the United States, now in force, under which this trade-mark was registered, relate only to trade-marks specially used in commerce with foreign nations or with the Indian tribes. Act of March 3, 1881 (21 St. a L., Chap, 137, Sec. 1). They are particularly restricted so as not to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe. (*Id.*, Sec. 11.) *The goods on which the trade-mark in question is used are not intended to be transported to any foreign country, nor for any Indian tribe, but are mineral waters sold for consumption in*

the City of New York; and the parties are all citizens of the State of New York.

"As this case is now presented, the orators are not entitled to maintain it in this court, and this motion for a preliminary injunction must be denied."

In *Hennessey et al.* v. *Braunschweiger & Co.,* 89 Fed. Rep., 664, Judge Hawley said:

"These propositions, as was said in the *Trade-Mark Cases,* are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them. Interpreting the various provisions of the Act of 1881 in the light and reason afforded by the decided cases, my conclusion is that the complaint does not state a cause of action against the respondent for an infringement of complainants' trade-mark; that complainants, in order to enable them to maintain this suit, are not required to aver that the parties were engaged 'in foreign commerce or commerce with Indian tribes'; and that such averment is essential only in cases where the action or suit is between citizens of the same State. It follows from the views expressed that the protection afforded to trade-marks under the common law, by the United States courts, is ample, and that registration under the Act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States Courts."

See, also, *Elgin National Watch Co.* v. *Illinois Watch Case Co.,* 199 U. S., 365, and *Trade-Mark Cases,* 100 U. S. 82.

INTERPRETATION OF THE ACT OF MARCH 3, 1881.

Section 1 provides that owners of trade-marks *used in commerce with foreign nations or with Indian tribes,* provided such owners shall be domiciled in the United States

or located in any foreign country, or tribe, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with certain requirements which are set forth.

Section 2 provides for the filing, with the application, of a declaration under oath, setting out various matters which are recited, and this is made necessary in order to create any right whatever in the party filing the application. The declaration must allege exclusive right at the time to the trade-mark, that it is used in commerce with foreign nations or Indian tribes, and that the description and fac-similes presented for registry are true representations.

Section 3 prescribes conditions in the matter of registry, *primarily, that the alleged trade-mark shall appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, or is within the provision of a treaty, convention, or declaration with a foreign power.* Further conditions are that the right to the trade-mark must be existent and exclusive, matters to be determined by the Commissioner of Patents.

Section 4 prescribes the manner of issuing certificates of resigtry, and that certified copies shall be evidence in a suit.

Section 5 prescribes the duration of the right under the registration, and the manner of renewal. The time is thirty years, but if the articles are not manufactured in this country, and the trade-mark has received protection for a shorter time in a foreign country, "it shall cease to have any force in this country *by virtue of this act* at the time the trade-mark ceases to be exclusive property elsewhere."

Section 6 relates to the crediting of fees paid for registration of the same trade-mark under the previous act.

Section 7 in full is as follows:

"That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy."

Section 8 provides that no suit shall be maintained under the provisions of the Act where the trade-mark is used in an unlawful business, or on injurious articles, or for deception, or under fraudulent registration.

Section 9 prescribes that an injured person shall have an action for damages against the registrant for fraudulent registration.

Sections 10 and 11 in full are as follows:

"Section 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed."

"Section 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State,

> unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe."

Section 12 authorizes the Commissioner of Patents to make rules and prescribe forms for transfer and recording transfers.

Section 13 in full is as follows:

> "That citizens and residents of this country wishing the protection of trade-marks in any foreign country the laws of which require registration here as a condition precedent to getting such protection there may register their trade-marks for that purpose as is above allowed to foreigners, and have certicate thereof from the Patent Office."

There are subsequent acts, but they in no way affect the foregoing. The Act of August 5, 1882, provides that nothing in the Act of March 3, 1881, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of that act. Another (R. S., 2496; p. 458) is a prohibition upon the importation of simulated watches, watch movements, etc.

From beginning to end, the Act of March 3, 1881, concerns itself with nothing but trade-marks used in foreign commerce, or commerce with Indian tribes, except Section 13, which provides for a special registration for a particular purpose.

In their attempt to construe Section 7 of the Act, appellant's counsel have fallen into the error of mistaking the gist of the action, in an action on the case for damages under the first part of the section. Having done this, they are compelled to distort the plain meaning of the second part, pertaining to equity jurisdiction, in order to make it con-

sistent with their interpretation of the first part. Thus, on pages 9 and 10 of their brief, they say:

> "Section 7 of the Act of March 3, 1881, then provided * * * that any person who should *counterfeit it* should be liable to an action on the case for damages, and that the party aggrieved should also have his remedy in equity to enjoin the *wrongful use* of such trade-mark and to recover compensation therefor," etc.

It will be seen that they seek to make the *reproduction, counterfeiting, copying, or colorable imitation and affixing* of the trade-mark the gist of the action, instead of making the *wrongful use* the gist of the action. Otherwise stated, they seek to have the first part of the section construed as if it read, "Any person who shall reproduce, etc., any trade-mark registered, etc., and affix the same, etc., shall be liable to an action on the case for damages *therefor*"; whereas that is not at all what the statute says. No ground of action whatever is given by the statute for the *mere* reproduction, counterfeiting, copying or colorable imitation of the trade-mark and affixing it; but this having been done, as an obviously essential prerequisite, the statute provides for an action on the case for damages for the *wrongful use* of the trade-mark which has been so reproduced, counterfeited, copied or colorably imitated and affixed. Understanding the *wrongful use* of the trade-mark copied or imitated and affixed, and not the mere copying or imitating and affixing, to constitute the gist of the action in the first part of the section, the language of the second part, which provides for equitable relief also, is perfectly clear, simple and natural. It is, "and the party aggrieved shall *also* have his remedy according to the course of equity to *enjoin* the *wrongful use* of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensa-

tion therefor in any court having jurisdiction over the person guilty of *such wrongful act.*" What wrongful act? The *wrongful use* within the purview of the statute, that is, the use in foreign commerce, or commerce with Indian tribes, of the registered trade-mark which has been reproduced, counterfeited, copied or colorably imitated, and affixed to merchandise of substantially the same descriptive properties as those described in the registration.

The closing part of the section is the jurisdictional part, and comprehends both the proceeding at law and the proceeding in equity of the preceding part of the section, founded on the *wrongful use* within the scope, purview, contemplation, or constitutional limitation of the Act, of the copy of the registered trade-mark, affixed to merchandise of substantially the same descriptive properties as those described in the registration. The language is, "and courts of the United States shall have original and appellate jurisdiction *in such cases* without regard to the amount in controversy."

On pages 12 to 14 of their brief, appellant's counsel argue for their contention that the gist of the action in the first part of Section 7 is the *copying* of the registered trade-mark and *affixing the copy to the merchandise,* this constituting the "wrongful use," as against the contention that the gist of the action is the *wrongful use,* within the purview of the statute, of the mark so copied and affixed, and they then devote pages 15 to 18 to an attempt to make the second part harmonize with the first on that theory.

Regarding the *wrongful use,* within the purview of the act, as the gist of the action, Section 10 becomes equally simple and direct. It is that nothing in the act shall prevent, lessen, impeach or avoid any remedy at law or in equity which *any* party aggrieved by *any* wrongful use of

any trade-mark might have had if the provisions of the act had not been passed. Hence the act only permits the registrant to elect a particular forum if he desires to make a special point of interference with his rights under his registered trade-mark in foreign trade, or trade with Indian tribes, leaving him free, however, to assert his rights as to a common-law trade-mark either in the State Courts or Federal Courts as the circumstances may justify or require, all as if the act did not exist.

The manifest intent of Congress in passing the Act of 1881 was to avoid the mistake by which the previous law was rendered unconstitutional, that is, interference by the Federal government with local trade. If the 7th section is to be construed as appellant's counsel contends, viz, that Federal Courts may enjoin the wrongful use—that is, use without authority—of the registered mark wherever it may occur, then the United States Court is given authority to interfere with local trade as well as trade among the States, with foreign nations and with the Indian tribes. This is the very mistake which invalidated the previous law and which Congress clearly intended to avoid. On the other hand, if the evident purpose of the law of 1881 is kept in view while reading Sec. 7, it will be manifest that the intervention of the Federal Court by virtue of the registration is authorized only with the same class of trade as the rest of the act concerns itself with, by permitting the registration of trade-marks. It follows that under the registration alone, the court may only enjoin the wrongful use of the registered trade-mark in foreign commerce, or in commerce with Indian tribes, the registrant being left to his other remedies when the wrongful use consists in the use of the mark in domestic trade.

THE TESTIMONY.

2. *The proofs in the case do not show that the complainant ever used his alleged trade-mark in foreign commerce, or in commerce with an Indian tribe, since the two consignments to Australia referred to in the declaration filed in the United States Patent Office in November, 1882, for the purpose of obtaining registration.*

3. *The testimony is silent as to any use by the defendants of the designation charged to infringe, either in foreign commerce or commerce with an Indian tribe .*

4. *The testimony shows no sales by defendant of a medicinal preparation having the designation charged to infringe, except in the City of Chicago in the Northern District of Illinois, and there is no suggestion anywhere in the record that the medicinal preparations of the defendants having the designation charged to infringe were intended to be used in commerce with foreign nations or with Indian tribes.*

The showing of the pleadings and the showing of the testimony are considered separately for the reason that it is not clear from the decisions of this court first cited whether the testimony is examined by the court on a motion of this nature. At all events, it is not likely that the court will desire to examine into the testimony if the pleadings alone have made it clear that no appeal lies.

The testimnoy with reference to the use by the complainant of his alleged trade-mark in foreign commerce is in substance as follows:

Mr. Warner, the original complainant, testified to a sale in September, 1881, to W. H. H. Lane, of Sydney, New South Wales, invoiced at $16 (NOT $165, as implied at

page 7 of the brief of appellant's counsel) and which he said was the first sale to anyone in a foreign country (Rec., p. 33), and Mr. Ramsey, another witness for the complainant, testified to the same sale and to a second one in the early part of 1882, the latter being to Hatton & Laws of Launceton, Tasmania. The shipment took place March 29, 1882 (Rec., pp. 39-40). Further reference to the second sale is to be found in the same deposition on pages 41, 42 and 43. On page 37 of the record Mr. Ramsey is asked the following question:

> "Q. If you know, state when Wm. R. Warner & Co. used this trade-mark in commerce with foreign nations."

To this he replied:

> *"Prior to application for registration."*

There is not a word of testimony to the effect that Wm. R. Warner & Co. ever used the alleged trade-mark in commerce with foreign nations or with Indian tribes at any later time. The application for registration was made November 18, 1882 (Rec., pp. 164-166), and the declaration forming part of the trade-mark application and sworn to on the 2nd day of December, 1882, refers to New South Wales and *Victoria* as the foreign countries in commerce with which the trade-mark had been particularly used. Apparently *Victoria* should have read *Tasmania*. On page 18 of the record, Mr. Remick, in answer to Q.-5, which inquired as to the efforts of Wm. R. Warner & Co. toward introducing "Pancreopepsine," mentioned advertising the preparation through the drug and medical journals of this and *other countries;* sending special literature to *different parts of the world* to physicians, and giving away special advertising matter and samples to physicians at various world's

fairs *in many countries*. He says nothing, however, to the effect that any sales were made in foreign countries, nor as to when the acts he mentions took place.

The sole proof of alleged infringement by the defendants is confined to sales by them of their medical preparations with the designation complained of in the city of Chicago, as may be seen by the depositions of Messrs. Benson, Thorburn, Remick and Stolze (pp. 11 to 31 of the record). For the sale referred to by Mr. Benson, see pp. 11 and 12, Q. 6-11; for the testimony of Mr. Thorburn on the subject, see page 17, Q. 10-12; for the testimony of Mr. Remick on the subject, see p. 20, Q. 14-16; and for the testimony of Mr. Stolze on the subject, see p. 29, Q. 4-7.

Thus it will be seen that this case, regarded from every aspect, rested from beginning to end upon the alleged common law trade-mark of the complainant, and in no sense whatever upon the registered trade-mark, so that the jurisditcion of the United States Circuit Court was dependent *entirely* upon the opposite parties to the suit being citizens of different States. This being true, it seems obvious that this court is without appellate jurisdiction of the case, and that the appeal should accordingly be dismissed.

BRIEF ON THE MERITS.

It is proper to say at the outset that this case, so far as the testimony goes, is entirely free from any question of unfair competition, and both the lower tribunals so held. The record shows that the defendants adopted their designation "Pancro-Pensin" as a euphonious term of description, intended to indicate the character and purpose of the medicinal

preparation to which it was applied by a legitimate verbal compound of the names of the two principal ingredients; that when they did this they had no knowledge that the complainant claimed a trade-mark right in any designation resembling it, or was using any such designation; that no charge is made in behalf of the complainant that the defendants have attempted, by the forms of their bottles or packages or by the appearance of their labels, to simulate the wares or labels of the complainant; and that there is no charge that the defendants have at any time attempted to palm off their product as the product of the complainant. In a word, it is apparent from the entire record that the defendants have acted throughout in perfect good faith, and have never sought to make any gain by false representations of any nature; that they have used their corporate name conspicuously on their packages, and that they have taken all possible precaution to identify their goods as of their own manufacture. A comparison of the packages, bottles and labels of the defendants with those of the complainant can not fail to make it manifest to the Court that no imitation was ever thought of. The defendants, as the record fully shows, and without contradiction, have proceeded throughout in perfect honesty and fairness, seeking only to establish a reputation of their own and intending to injure no one. It was only after the reputation of their goods had become in a measure established that they were made aware of the claim of infringement by the complainant. Under all the circumstances, they did not feel that this claim was one which they could, in justice to themselves, recognize or submit to, and hence this suit was brought, which presents a somewhat unusual aspect in trade-mark litigation, neither side charging the other anywhere throughout the testimony with conduct unbecoming an honorable business man. The issues, aside from the question of jurisdiction and the effect

of the Illinois statute, are simply whether the designation "Pancreopepsine" is a legitimate trade-mark, whether complainant has established an exclusive right to it as a common law trade-mark, and if so, whether the defendants, by the use of the designation "Pancro-Pepsin," have infringed it.

NOT A LAWFUL TRADE-MARK.

When complainant applied to a liquid composition of *pancreatin* and *pepsin* the designation "Liquid Pancreopepsine," he was employing apt descriptive terms to indicate its *character* and *composition*. Such terms define the article rather than its origin. They can not be appropriated as a trade-mark, for everybody who makes or sells such a composition is equally entitled to the terms which carry information concerning its character and composition.

Nor does it appear that this name of the article has ever been understood by the trade to be anything else than its name. Plainly its primary office has been to describe the article. Complainant neither has acquired nor could he acquire exclusive right to it.

A fundamental principle which appertains to trade-marks is that every one has a right to call a thing by its appropriate name. Another is that every one must deal honestly in connection with his trade-mark in order to have any standing in court. Out of these principles has grown the doctrine that a trade-mark in order to be valid must be neither descriptive nor deceptive. If descriptive, no one can have an exclusive right to it. If deceptive, the courts refuse it recognition. As shown by the testimony, pancreatin and pepsin were well known in medicine and pharmacy as remedial agents in digestive disorders for a great many years before the complainant made his compound, and as shown by the defendants' exhibit, Articles from American Journal of Pharmacy,

1871, printed on page 274-8 of the joint record, pancreatin and pepsin had been combined or commingled for many years before the complainant made his compound. The formula for complainant's compound is not given in the description attached to his registered trade-mark, and it is not fully given in the testimony. All that is known of the composition is to be found in the cross examination of William R. Warner, the complainant, at page 35, as follows:

> "X. Q. 22. Referring to complainant's exhibit certificate of registration of trade-mark, what are the main ingredients of the medicinal preparation in connection with which this trade-mark was adopted?
>
> "A. Pepsin, muriatic, lactic, and phosphoric acids and pancreatin. These are not all, but the chief ingredients.
>
> "X. Q. 23. Has the formula for this preparation remained unchanged since you began to use the mark?
>
> "A. Substantially the same. Saccharated pepsin was used in the beginning and now a more perfect and stronger pepsin known as scale pepsin, 3,000 test.
>
> "X. Q. 24. Pepsin and pancreatin are contained in greater quantities in this preparation than the other ingredients, are they not?
>
> "A. They are not. That is, pancreatin is not."

The complainant designated his medicinal compound "Liquid Pancreopepsine," which, on its face, is obviously intended to signify that the compound is a digestive agent in liquid form, containnig, as important ingredients, the well-known substances pancreatin and pepsin. Whenever any medicinal agent acquires a popular reputation as having virtues in a certain direction, manufacturers of proprietary remedies are quick to take advantage of it and put alleged remedies upon the market with the name of the supposed beneficial substance as a catchword. At about the date of complainant's trade-mark registration a vast number of per-

sons who had, or imagined they had, indigestion, were taking pepsin or pancreatin or the two together, and probably, in many cases, they were more or less benefited. At all events, these two substances were, and have ever since continued to be, recognized and popular remedies for indigestion, and the complainant in this cause, obviously seeking to avail himself of the popular favor in which these substances were held, sought to give, and did give, his digestive compound a name plainly indicative of their presence. If the designation is entitled to any recognition at all as a coined or fanciful term, it is only upon the ground that a purposely misspelled word might receive such recognition. The designation "Pancreopepsine" is awkward from the standpoint of word-building. Nevertheless, being plainly indicative of what it is intended that the public shall understand the compound contains, it is by far too descriptive in its character to be a legitimate trade-mark. A trade-mark, to be valid, should consist of an arbitrary sign, symbol or name, not descriptive of the article with which it is associated. Descriptive terms belong to the public at large and can not be monopolized. But even witnesses called in behalf of the complainant on the *prima facie* showing said that they understood from the designation that the substance called Pancreopepsine was a digestive agent containing pancreatin and pepsin. On this subject Mr. Andrew J. Benson, a Chicago druggist, testified under cross-examination, as follows, Rec., 13-14:

> "X. Q. 11. Do you know for what general purpose 'pancreatin' and 'pepsin' are used in medicine?
>
> "A. Pepsin is used as an aid for digesting starchy and albuminous food; and pancreatin for digesting the fats and oils.
>
> "X. Q. 12. This being true, would a compound containing both pancreatin and pepsin be in the nature, theoretically, of a general digestive?

"A. Yes, but there are other organs of digestion besides the stomach and bowels.

"X. Q. 13. When you filled Dr. Bate's prescription, did you give any thought to the general purpose for which the compound called for was probably intended?

"A. *Yes, I thought it was to be used for an aid to digestion.*

"X. Q. 14. Why so?

"A. *Because I supposed from the name that the prescription contained pancreatin and pepsin, which are used for that purpose.*

"X. Q. 15. At the time you filled Dr. Bate's prescription, did you have liquid Pancro-Pepsin of the Searle & Hereth Company in stock?

"A. Yes.

"X. Q. 16. Did you know from the name the general purpose for which it was used in medicine?

"A. I supposed it was used as an aid to digestion.

"X. Q. 17. *What ingredients did you understand from the name that it contained?*

"A. *I supposed that it contained pancreatin and pepsin.*"

Complainant's counsel tried hard to turn the edge of the foregoing answers in the re-direct examination, but with no success, as will be apparent upon examining the testimony.

Mr. Frederick E. Stolze, another witness called by the complainant, on the *prima facie*, testified as follows, page 31:

"R. D. Q. 35. In naming, as you did in cross examination, the principal ingredients of the Searle & Hereth preparation called 'Pancro-Pepsin,' did you base your answer upon any definite information or did you merely give a rough guess at it?

"A. Just guessed at it.

"R. X. Q. 36. In making the rough guess, to which you have referred, what caused you to guess that pancreatin and pepsin were the two leading ingredients of

the preparation 'Pancro-Pepsin,' manufactured by the Searle & Hereth Company?

"A. If the medicine is good for indigestion, it takes those things to make it valuable, and I naturally guessed that as long as they have it on their label they have it inside, too."

The subject of the essentially descriptive nature of the designations "Pancreopepsine," employed by the complainant, and "Pancro-Pepsin," employed by the defendants, is fully considered in the deposition of Dr. Walter S. Haines, professor of chemistry at Rush Medical College, Chicago. The whole matter is contained in the direct examination of Dr. Haines, beginning at page 57 of the record and ending at page 63. It will be seen that Dr. Haines fully bears out our contention above, that both designations "Pancreopepsine" and "Pancro-Pepsin" are essentially descriptive in their nature, and definitely signify to any one familiar with pharmacy the presence of the well-known medicinal agents pancreatin and pepsin, and necessarily imply that the compound so named is a remedy for indigestion. Dr. Haines points out that the defendants' designation "Pancro-Pepsin" is more correctly formed, according to the system of chemical nomenclature, than that of the complainant, and that it distinctly implies, and could only imply, a remedy for indigestion containing the substances pancreatin and pepsin. It follows that if a medicinal preparation were called Pancreopepsine or Pancro-Pepsin, and did not contain both pancreatin and pepsin, it would be misleading and fraudulent, and so Dr. Haines says in answer to Q. 12 on page 61.

The following excerpts from the deposition of Dr. Haines state the defendant's position so clearly and ably that we reproduce them here for convenience of reference, though we shall be glad to have the court read the entire deposition:

"Q. 3. I call your attention to several exhibits offered in evidence in behalf of the defendant in this cause, as follows: 'Defendant's Exhibit Package Pancro-Pepsin Powder,' 'Defendant's Exhibit Hereth Specimen Liquid Pancro-Pepsin,' 'Defendant's Exhibit Defendant's Pancro-Pepsin Elixir No. 1' and 'Defendant's Exhibit Defendant's Pancro-Pepsin Elixir No. 2.' Please look at those exhibits and state what understanding, if any, is conveyed to your mind by the presence upon the labels of those several exhibits of the designation 'Pancro-Pepsin,' giving your reasons.

"A. I have examined the exhibits in question and would say that the designation 'Pancro-Pepsin' on their labels conveys to my mind the understanding that the chief constituents of the liquids and powder referred to are pancreatin and pepsin.

"A time-honored method of naming compounds of two or more substances is to use a term descriptive of the constituents; this, in fact, is the underlying principle of the greater portion of chemical and pharmaceutical nomenclature, much the larger number of substances in chemistry and pharmacy receiving names that are descriptive of their chief constituents. There are many methods of carrying out this general principle, and among others that of making a compound word by uniting the names of the principal ingredients of the substance in question, and for the purpose of euphony and brevity the latter part of the name of one of the constituents is often elided and the letter 'o' substituted for it. Illustrations of this method of nomenclature are numerous and have been found on the pages of works devoted to chemistry and pharmacy for many years—in fact, when I began studying chemistry and medicine more than a quarter of a century ago such names were in frequent use. Among names of this kind which have been used for many years I may mention 'nitro-glycerine,' a substance produced from nitric acid and glycerine; 'nitro-benzene,' a compound obtained from nitric acid and benzene; 'oleomargarine,'

a fat supposed, at the time it was named, to be composed of oleine and margarine; and 'oleoresins,' substances which are made up chiefly of oils and resins. A very large number of other similarly constructed names might easily be given. In Watt's Dictionary of Chemistry, Vol. 5, bearing the date of 1874, I find easily more than two dozen descriptive names built up on this principle; and in the index to Gmelin's Hand-Book of Chemistry, published at an earlier date than Watt's Dictionary, I find also a large number of words constructed in the same manner."

From the above it is clear that when in chemistry or pharmacy we find a compound word like "pancro-pepsin" we know that it is descriptive of the chief constituents of the substance it is applied to. It is inevitable, therefore, that we should consider pancreatin and pepsin as the principal component parts of the material contained in the exhibits in question, as I have already stated.

"Q. 4. Speaking from your personal knowledge, was it customary, for purposes of description, to compound the names of substances in the manner you have stated prior to the year 1876?

"A. It was; all the names given above as illustrations were used commonly prior to the year 1876.

"Q. 5. Speaking from your knowledge as a pharmaceutical chemist and physician, are you able, upon seeing a medicinal compound labeled 'pancro-pepsin,' to arrive at any conclusion as to its medicinal purpose or ostensible medicinal purpose? If so, please state the conclusion and give your reasons.

"A. Upon seeing a medicinal compound labeled 'pancro-pepsin,' I should know, from my knowledge of chemical and pharmaceutical nomenclature, that the substance contained pancreatin and pepsin as its chief constituents, and as both of these are used as agencies to promote digestion I should, without hesitation, arrive at the conclusion that the compound was designed

as a medicinal substance to aid the process of digestion.

"Q. 6. What is pancreatin, and for what purpose is it used in medicine?

"A. Pancreatin is the active constituent of the pancreas. As found in pharmacy it is a powder and is generally extracted from the hog. It has the power of digesting practically all kinds of food, converting proteids into peptones, starch to sugar and fats into emulsions. On account of this property it is used in medicine as an aid to digestion, either by mixing it with the food out of the body or by administering it internally.

"Q. 7. What is pepsin, and what are its functions in medicine?

"A. Pepsin is the chief active constituent of the gastric juice. When combined with acids it has the power of converting proteids into peptones and thus rendering them soluble and capable of assimilation. On account of this power it is often administered in medicine as an aid to digestion.

"Q. 8. In the designation pancro-pepsin, is there any substance in medicine other than pancreatin for which the prefix pancro could stand?

"A. Nothing with which I am acquainted. I have examined a large number of books dealing with medicinal substances, but I have been unable to find anything else whose name could by any possibility be changed into the prefix 'pancro.' The United States Pharmacopœia and the National Dispensatory, the latter of which especially is supposed to contain a nearly complete list of all substances used in medicine in this country, have been searched in vain for a name which could even be tortured into this prefix. It is true that the word 'pancreas' could give us the same prefix, but as this organ owes its activity entirely to the pancreatin contained in it, and would be administered, if used at all in medicine, for the sake of the latter, the prefix 'pancro,' even if derived from pancreas, would still refer, so far as medicinal use is concerned, to pancreatin.

"Q. 9. If a medicinal compound is given the designation 'Pancreopepsine,' what signification, if any, would that designation convey to a pharmacist or physician?

"A. It would convey the impression that the compound in question was composed of pancreatin and pepsin as its chief or most important constituents.

"Q. 10. For how long have you personally known of the substances pancreatin and pepsin, and of their functions as digestives?

"A. The substances pancreatin and pepsin and their value as digestive agents have been known to me for fully twenty-seven or twenty-eight years. I began reading medicine in 1870, and graduated three years later, and during that period pancreatin and pepsin and their use in digestion were frequently presented to me both by my text-books and by the lectures at the medical school.

"Q. 11. With the knowledge of the substances pancreatin and pepsin and their properties as medicinal agents in aiding digestion which you had prior to the year 1876, what would you have necessarily understood, at that time, upon seeing a medicinal compound bearing the designation either of pancreopepsine or pancro-pepsin? Please give your reasons in full.

"A. As I have stated in my preceding answers, I knew of pancreatin and pepsin for a number of years prior to 1876; I also knew of their value as digestive agents in the physiological processes of the body, and of their administration as medicinal agents to improve digestion. With the knowledge of these various points and with my knowledge also of the principles of chemical and pharmaceutical nomenclature, I should have known at once, upon seeing a medicinal compound bearing the designation either of pancreopepsine or pancropepsin, that it was composed of pancreatin and pepsin as its chief constituents. I could not possibly have been mistaken in this understanding, for there is no medicinal substance whose name could possibly be tortured either into 'pancreo' or 'pancro' except pan-

creatin, while the latter part of the word 'pepsine' or 'pepsin' could refer, naturally, to only one medicinal substance, namely, the active principle of gastric juice or pepsin (often also spelled pepsine).

"Q. 12. Suppose that a medical compound should be labeled with the designation 'pancreopepsine' or 'pancro-pepsin' when, as a matter of fact, it did not contain pancreatin and pepsin as its chief or only constituents, or as constituents in material quantity; what, under those circumstances, would you say concerning the appropriateness of the designation?

"A. Under such circumstances the designation 'pancreopepsine' or 'pancro-pepsin' would be not only inappropriate, but would be misleading and fraudulent.

"Q. 13. Please state, so far as you know, to what extent pharmacists and physicians were familiar with the substances pancreatin and pepsin and their properties in medicine prior to the year 1876, and what opportunities through standard publications were afforded for gaining such knowledge at that time.

"A. Pancreatin has been known to the scientific world since the year 1845, when it was discovered by the French chemists Bouchardat and Sandras, who not only isolated the substance, but correctly described it and noted that it possessed digestive properties in certain directions. Pepsin has been known equally long as the chief active constituent of the gastric juice and as a digestive agent of much power. It was natural that physicians and pharmacists should avail themselves of the discovery of two such potent agencies for digesting food, but it was a number of years before either of these bodies was brought to the general attention of the profession at large. Pepsin was the first to come into popular favor, and during the later 60's it was much written about and considerably prescribed by physicians. About the same time pancreatin began to be used in medicine, but to a much more limited degree. Physicians and pharmacists were afforded abundant opportunity of learning of the value of both these

agencies through the medium of well-known publications. The United States Dispensatory, a book extensively used by druggists and physicians, in its thirteenth edition, printed in 1872, has considerable articles upon both pepsin and pancreatin, and speaks of their value as therapeutic agents; and the American Journal of Pharmacy, a widely-read publication, contained articles upon both these substances in its volumes published during the early '70's. I have before me a bound volume of the last-named publication for 1871, and I find, by referring to its index, that there are seven articles in regard to pepsin, and one in regard to both pepsin and pancreatin, the latter appearing on page 24 under the heading, 'A Combined Solution of Pepsine and Pancreatine.' Most of the information contained in this article had been published the year before in the well-known English medical journal, 'The Lancet,' and in the London Journal of Pharmacy. I have also before me a bound volume for 1873 of the same American Journal of Pharmacy, and I find, by referring to its index, that it contains 'Notes on Pepsin,' on pp. 322, 356 and 374; and 'Pancreatin, Preparation and Properties,' on pp. 531 and 563. The article on p. 531 is entitled 'Notes on Pancreatin, by Richard V. Mattison (read at the Pharmaceutical Meeting, November 18). It covers more than two pages and describes a process of making pancreatin mixed with sugar of milk, to which the name 'saccharated pancreatin' is given, and the article also imparts considerable information concerning the properties of pancreatin in general."

Without going further in this matter, it is perfectly clear from the above that several years prior to 1876 both doctors and druggists had abundant opportunity of learning about pancreatin and pepsin and of their use in medicine.

* * * * *

"X. Q. 38. If you had never been told so by authorities and had never ascertained the fact by experiment,

you would not have known whether the term 'nitro-benzene' referred to a combination of benzene and nitric acid or referred to a combination of benzene with nitrogen, would you?

"A. If I were asked this question from the standpoint of scientific chemistry, I should say that even without any previous knowledge I should feel confident that nitro-benzene was a compound produced by the action of nitric acid on benzene, for the prefix 'nitro' in pure chemistry refers to compounds that are produced by the action of nitric acid; compounds with nitrogen alone are generally indicated by the prefix 'azo.'

"X. Q. 39. Can you cite any authority for this statement you have made in your last answer? I mean where such a rule is announced.

"A. I can cite the best of all authority, namely, scientific usage. If any reliable work on chemistry is referred to the correctness of my statement will be seen; 'nitro-benzene,' 'nitro-glycerine,' 'nitro-cellulin,' and many other similar names will be found to be applied to bodies produced by the action of nitric acid, while 'di-azo-benzene,' 'azo-colors' and other similar words containing the prefix 'azo' will be found to refer to compounds with nitrogen. Usage governs nomenclature as it does other forms of language, and a consultation with authoritative works on chemistry as surely gives us the rules of nomenclature as a specific statement would. I have no doubt, however, that the very rule I have laid down could be found in chemical publications if search were made for it. I can not now refer to any definite page and volume for an explicit statement in regard to this matter; neither can I state where we find the rule for the construction of such words as 'Anglo-American,' 'Franco-Prussian,' 'Austro-Hungary,' etc. We all of us know by experience that a rule governs the formation of such compound words as these latter, yet it would be difficult, and perhaps impossible, to put one's finger on a specific printed statement to that effect."

Prof. Haines is cross examined at great length, the cross examination extending from page 63 to page 94, but the position taken in his direct examination remains unshaken, and it obviously could not be shaken, since it is, on its face, rational and correct. The principal effort of the cross-examination seems to have been to make it appear that the prefix *pancreo* or *pancro* might refer to some substance other than pancreatin; but as Prof. Haines points out, the substance pancreatin has been on the shelves of every drug store for the past twenty-five years or more, is a well-known digestive agent, and any idea that the prefix *pancreo* or *pancro* in association with the word *pepsin* could refer to any substance other than pancreatin would be strained, unnatural and absurd. Moreover, the complainant, William R. Warner, testifies under cross examination (X. Q. 22, p. 55), that his preparation contains both pancreatin and pepsin, from which the reason for his adopting the name "pancreopepsine" may easily be gathered. This case is identical in principle with *Caswell* v. *Davis*, decided in the New York Court of Appeals, 58 N. Y., 223. The plaintiffs were compounders of a medicine which they called "Ferro-Phosphorated Elixir of Calisaya Bark," and the defendant, who had been in the plaintiff's employ, began to sell another preparation as "Davis & Son's Original and Genuine Ferro-Phosphorated Elixir of Calisaya Bark." Suit was brought for an injunction to restrain the defendant from so doing. It was held on appeal that an injunction could not be granted to restrain the defendant from using the word *Ferro-phosphorated*, the word being descriptive of the composition of the medicine. The court, by Judge FOLGER, said:

> "There is no principle more firmly settled in the law of trade-marks than that words or phrases which have been in common use and which indicate the character, kind, quality, and composition of the thing may not be

> appropriated by any one to his exclusive use. In the exclusive use of them the law will not protect. Nor does it matter that the form of words or phrases adopted also indicates the origin and maker of the article. The combination of words must express only the latter. It is the result of all the decisions that known words and phrases indicative of quality and composition are the common property of all mankind. They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him."

The essential function of a trade-mark is to indicate the manufacturer of the particular article; that is to say, it is what has been called a "commercial signature" intended to show that the goods are of a particular manufacture, and to distinguish them by that mark from the products of other manufacturers of the same kind of goods. It follows that the mark or designation must not be descriptive of the kind or quality of the goods, because such a mark is equally open to all manufacturers of the same kind of goods. This principle is such a familiar one that perhaps no authorities upon it are necessary in this court, but it is so important in this case that we nevertheless present a few, as follows:

In *New York Asbestos Manufacturing Company* v. *Ambler Asbestos Air-Cell Covering Company*, 99 Fed. Rep., 85, Judge DALLAS said:

> "The impression now made upon my mind is that those terms" (air-cell or fire-board) "are descriptive of certain products; that they identify the manufactured articles with which they are associated, not the manufacturer thereof; and no more need be said upon the subject of trade-mark separately considered, upon this motion."

In *Rumford Chemical Works* v. *Muth.*, 35 Fed. Rep., 524, Judge MORRIS, on page 527, cites with approval, the decision in *Caswell* v. *Davis, supra,* and in that connection says:

> "The true test, it appears to me, must be, not whether the words are exhaustively descriptive of the article designated, but whether in themselves, and as they are commonly used by those who understand their meaning, they are reasonably indicative and descriptive of the thing intended. If they are thus reasonably descriptive and not arbitrary, they can not be appropriated from their use and become the exclusive property of any one. This rule is clearly explained and applied by Judge FOLGER, speaking for the Court of Appeals of New York, in the case of *Caswell* v. *Davis,*" etc.

Further on Judge MORRIS says:

> "In the case then before the New York Court of Appeals, the plaintiffs, Caswell, Mack & Co., had prepared a medicine to which they had given the name Ferro-Phosphorated Elixir of Calisaya Bark. The plaintiffs were the first to invent and use the combined word ferro-phosphorated, and gave it to the preparation to distinguish it as the preparation made by themselves and also to announce that there were iron and phosphorus in it. This, it was decided, they could not do to the exclusion of other persons, for although the combined word was their own invention and did, as their trade-mark, indicate the origin and maker of the article, it did more, and by words which were of common significance, it indicated that the ingredients iron and phosphorus were combined with the calisaya bark, and therefore it could not be protected as a trade-mark. This case only applies the recognized ruling in many other cases."

What is said by Judge Morris in the above excerpt fits the present case in every particular, though the equities are

infinitely stronger in favor of the defendants in this case than they were either in the case of *Caswell* v. *Davis* or the case of *Rumford Chemical Works* v. *Muth;* because the defendants in this case adopted their designation independently, without knowledge of the complainants, for the avowed purpose of employing a descriptive term, and in this they did not adopt the precise form used by the complainant, but one which, in the nature of things, must and does more or less resemble it. The same general doctrine is clearly announced in the Supreme Court decision in *Canal Company* v. *Clark,* 13 Wallace, 311. On page 323, the court says:

> "No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced by himself. If he could the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, nor a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection. As was said in the well-considered case of *Amoskeag Manufacturing Company* v. *Spear,* 'the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms or symbols that are appropriate as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures or symbols, which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.'"

Also (p. 327):

"It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it. True, it may be that the use by a second producer in describing truthfully his product of a name or a combination of words already in use by another may have the effect of causing the public to mistake as to the origin or ownership of the product, but if it is just as true in its application to his goods as it is to those of another who first applied it, and who therefore claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth."

In *Colgan et al* v. *Danhaser et al.*, 35 Fed. Rep., 150, Judge GRESHAM said:

"The complainants have no patent which secures to them a monopoly in the exclusive use of the ingredients which constitute their goods or in the goods themselves. The words 'Taffy Tolu' indicate or describe the character of the labeled goods rather than their origin. The defendants have an equal right to make and sell Taffy Tolu, provided they make and sell it as their own manufacture, and not as that of the complainants. The words being descriptive of the compound or goods, they are incapable of appropriation. The proper designation of an article can not be appropriated as a trademark; and it is quite immaterial who first gives the proper name to a new article. The defendants are at liberty to make and sell Taffy Tolu, the same or similar in ingredients as the complainant's manufacture, provided they label and sell the article as made by themselves and not by the complainants, which they seem to be doing."

In *Carbolic Soap Company* v. *Thompson*, 25 Fed. Rep., 625, Judge PARDEE held the designation Buchan's Cresylic Ointment to be incapable of appropriation as a trade-mark. In the course of the opinion he says:

> "There is an article—a product of coal tar—known in commerce and in manufactures as cresylic acid. Whether, among chemists and scientific people, this distinctive cresylic acid is regarded as only impure carbolic acid or crude carbolic acid, or whether it should be called 'cresol,' 'cresylic alcohol,' 'hydrate of cresyl,' 'hydrate of ovide of cresyl,' 'cresylic acid' or 'cresylol' is immaterial for this case. * * *
>
> "The word cresylic when applied to distinguish an ointment and the article known in commerce as cresylic acid is descriptive of the nature and quality of the compound. * * * From these facts it follows that complainants have no right to the exclusive use of the word 'cresylic' as a trade-mark, or to distinguish Buchan's Cresylic Ointment or any compound of which the cresylic acid of commerce is an ingredient, but the complainant ought, in equity and good conscience, to be protected from the imitation of its packages, so far as they are peculiarly designed and shaped for the purpose of distinguishing complainant's goods, and from the imitation in color, design, style and lettering combined, of the labels used to make said packages when put on the market. * * *"

When reference is made further on in this brief to the deposition in rebuttal of Dr. Coblentz, it will be seen that the above decision is peculiarly in point in the present case. In seeming analogy to the methods of the experts in the above case, Dr. Coblentz undertakes to show that the designations "Pancreopepsine" and "Pancro-Pepsin" can not be regarded as descriptive so far as the prefix "pancreo" or "pancro" is concerned, because pancreatin has no definite signification in chemistry, and is not recognized by scientific

chemists. He says that there is such a thing as *commercial* pancreatin, but contends that the substance is very variable in its composition as supplied to the market by the different manufacturers.

A *commercial* term, however, is rather more likely to be used and understood in a descriptive sense than a strictly technical term. It is to the commercial world rather than the purely scientific that the manufacturers and dealers usually address themselves.

In *Hostetter* v. *Fries,* 17 Fed. Rep., 620, Judge WALLACE said:

> "When a new article is made a name must be given to it, and this name becomes, by common acceptation, the appropriate descriptive term by which it is known, and therefore becomes public property. If this were not so any person could acquire the exclusive right to a formula by giving a name to the compound produced, not only when the compound has not been patented, but when it might not be the subject of a patent. All who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the mannufacture of the seller and not the preparation made by another. A trade-mark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article. A name alone is not a trade-mark when it is understood to signify not the particular manufacture of a cetrain proprietor, but the kind or description of thing which is manufactured."

In *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.,* 138 U. S., 537, complainant claimed a right in the use of the capital letters "L. L." applied to sheeting. The defendant admitted having applied these letters to sheeting, but denied that the

letters were understood to indicate the origin of the goods, alleging that they were used by the complainant to distinguish certain grades of goods. The court, in its opinion, quoted at length from *Canal Company* v. *Clark,* saying (p. 547):

> "We quote thus at length, because the decision is a leading one, which has been repeatedly referred to and approved as presenting the philosophy of the law applicable to trade-marks, in a clear and satisfactory manner, as should also, indeed, be said of Judge Duer's noted opinion in the case therein cited."

After citing numerous decisions subsequent to *Canal Company* v. *Clark,* the court proceeded (p. 547):

> "Nothing is better settled than that an exclusive right to the use of words, letters or symbols, to indicate merely the quality of the goods to which they are affixed, can not be acquired. And while if the primary object of the mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that it has also become indicative of quality, is not of itself sufficient to debar the owner from protection, and make it the common property of the trade (*Burton* v. *Stratton,* 12 Fed. Rep., 696), yet if the device or symbol was not adopted for the purpose of indicating origin, manufacture or ownership, but was placed upon the article to denote class, grade, style or quality, it can not be upheld as technically a trade-mark.
>
> "*Manufacturing Co.* v. *Trainer, supra,* which involved the use of the letters 'A. C. A.' in connection with a general device constituting a trade-mark, is very much in point, and the discussion by Mr. Justice Field, who delivered the opinion of the court, leaves little, if anything, to be added here. In that case as in this, there was some evidence tending to show that it was understood that the letters were used to indicate origin as well as quality, but it was considered to be

entirely overborne by the disclosure of the name of the manufacturer in full and the history of the adoption of the letters to designate quality only, as narrated by complainant."

In *Coates* v. *Merrick Thread Co.*, 149 U. S., 562 (particularly pages 572-3), where a certain arbitrarily selected number (40) had been used to represent a thread of a particular size, the Supreme Court held very emphatically that there could be no monopoly of such a mark and that marks *" used for the purpose of imparting information" were "not " susceptible of exclusive appropriation as a trade-mark, but " are the common property of all mankind."*

In *Columbia Mill Co.* v. *Alcorn*, 150 U. S., 460, the Supreme Court thus summarizes the law of trade-marks, after quoting numerous decisions (p. 463):

> "These cases establish the following general propositions: (1) That to acquire the right to the exclusive use of a name, device, or symbol, as a trade-mark, it must appear that it was adopted for the purpose of identifying the origin or ownership of the article to which it is attached, or that such trade-mark must point distinctively, either by itself or by association, to the origin, manufacture, or ownership of the article on which it is stamped. It must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity, and to distinguish it from like articles manufactured by others. (2) That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style or quality, or for any purpose other than a reference to or indication of its ownership, it can not be sustained as a valid trade-mark. (3) That the exclusive right to the use of the mark or device claimed as a trade-mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles

of production. (4) Such trade-mark can not consist of words in common use as designating locality, section, or region of country."

In holding that the word "Columbia," which the complainant had applied to flour in its manufacture, was not a valid trade-mark, the court said (p. 466):

> "It can no more be said that it was intended to designate origin or ownership than to denote the quality of the flour on which the brand was placed, and the proof tends strongly to show that the whole label was intended to indicate the quality, or class, or character of the flour, as being made of spring wheat instead of winter wheat."

It further said (p. 467):

> "The proof fails to establish that the brand of the appellees was calculated to mislead, or did actually deceive or mislead, any one into supposing that the flour of the complainant was being bought. So it can not be said that the defendants were personating the complainant's business by using such a description or brand as to lead customers to suppose that they were trading with the appellant."

In *Hostetter* v. *Fries*, 17 Fed. Rep., 620, Judge WALLACE, in refusing to enjoin the use of the words "Hostetter's Bitters," which the complainant asserted as a trade-mark, said (p. 622):

> "A trade-mark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article. A name alone is not a trade-mark when it is understood to signify, not the particular manufacture of a certain proprietor, but the kind or description of thing which is manufactured."

In *Leclanche Battery Co.* v. *Western Electric Co.*, 23 Fed. Rep., 276, complainant had applied to its batteries the words

"Disque" or "Pile-Leclanche," and also used a peculiar label in connection with these marks. The defendant had copied the label, including these words. Complainant sought to enjoin the use of these words, as well as the use of the label. It appeared that the word "Disque" had been used by complainant to distinguish one form of battery made by it from another form, and that the word "Pile-Leclanche" was used to distinguish a certain style of battery. The court, through Judge Wallace, refused to enjoin the use of the word "Disque," or of the word "Pile-Leclanche," but granted an injunction against the imitation of the complainant's label, saying (p. 277):

> "When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable. *Hostetter* v. *Fries*, 17 Fed. Rep., 620; *Singer Manuf'g Co.* v. *Stanage*, 6 Fed. Rep., 279. As soon as Leclanche invented his battery in France, it was necessarily given the name 'Pile-Leclanche,' and that name could never again be appropriated exclusively as a trade-mark even by the inventor himself.
>
> "A name alone is not a trade-mark, when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing which is being sold."

Quoting various authorities.

In *Corwin* v. *Daily*, American Trade-Mark Cases, p. 265, the court says (p. 269):

> "Every reported case in courts of equity, however, that I have been able to find, recognizes, as I construe them, two principles: *First*, the necessity of an intent to injure the originator of the trade-mark, by passing off the wares of the offender as those of the former;

and, *secondly*, that if the trade-mark consists of words, they must indicate ownership and origin, and not merely other attributes, such as quality, kind, texture, composition, utility, destined use, or class of consumers. The encouragement of this exclusive use of a word, not indicating ownership or origin, as a name of anything, is not a matter of public policy; no great ingenuity of powers of invention are taxed or stimulated thereby."

See, also,

Amoskeag Mfg. Co. v. *Spear*, American Trade-Mark Cases, p. 87.

Corbin v. *Gould*, 133 U. S., 308.

Brown Chemical Co. v. *Meyer*, 139 U. S., 540.

Elgin National Watch Co. v. *Illinois Watch Co.*, 179 U. S., 665.

In *L. H. Harris* v. *Stucky*, 46 Fed. Rep., 624, heard by Judges Acheson and Reed, the court, by Judge REED, speaking of the effect of registration under the act of March 3, 1881, said:

"The evident purpose of the act was, by registration, to protect an existing valid trade-mark, when used in certain cases, not to create, by the registration, a trade-mark which had otherwise no existence or validity. As in the construction of the penal statutes of the United States it is frequently necessary to look to the common law in order to ascertain the nature of the crime and the definition of the term used by the statutes, so, in applying the act of 1881, and ascertaining the rights conferred by it, it is necessary to turn to the decisions of the courts for the rule which will define the valid, legal trade-mark which is protected by registration under the act. By the exception of certain specified things from registry Congress has limited the trade-marks which may be registered, but it has not said that those which are registered are thereby made valid trade-marks. Such a construction of the act would be con-

trary to the well-known doctrine of the trade-mark cases, 100 U. S., 82. * * *"

It is plain from the foregoing decisions and many others which might be cited, that the fact that the Patent Office permitted the designation "Pancreopepsine" to be registered under the act of 1881, imposes no obligation upon the courts to assume it to be a valid trade-mark. In the present instance the fact of registration is not even persuasive in this behalf, because the description in the complainant's trade-mark registration contains no reference to the composition of the medicinal compound to which the term is applied, and there is no ground for assuming that the examiner of trade-marks is a pharmacist or chemist, or had any means of knowing that, as a matter of fact, the term was descriptive. The proofs in this case, however, are abundant, both by complainant's and defendants' witnesses, that the term is descriptive, and that most consumers as well as all persons skilled in pharmacy would at once understand from it not only the ingredients, or the leading ones, or the ones to which the attention of the public was primarily directed, but also its remedial purpose.

What the Defendants Have Done.

The members of the defendant company who were called as witnesses for the defense have given a frank and full statement of everything that has been done by the defendant company in the matter of putting "Pancro-Pepsin" upon the market. The first witness was Mr. Frank S. Hereth, who sets forth in his direct examination the complete history of the "Pancro-Pepsin" compounds which have been put upon the market by the defendants, and the manner and purpose of adopting the designation. (Rec., pp. 44-7.) For

convenience of reference we reproduce that portion of his deposition, as follows, the italics being ours:

"Q. 4. Does The Searle & Hereth Company manufacture and put upon the market any preparation or preparations to which it gives the name 'Pancro-Pepsin'?

"A. We make several preparations of this nature.

"Q. 5. Please describe generally the different preparations which you manufacture and designate by the name 'Pancro-Pepsin.'

"A. *The original preparation we made was in the form of a powder.* Since this preparation was introduced we have added to the list of preparations several elixirs, a liquid and a syrup. The pancro-pepsin in powder form is used for dispensing, in substance, either in bulk, powders, capsules, pills or tablets. The elixirs are flavored and sweetened hydro-alcoholic solutions of the pancro-pepsin itself. One of the preparations we make is a plain elixir of pancro-pepsin. In addition to this we make other elixirs containing various chemical salts, such as pyro-phosphate of iron, quinine, strychnine, etc. The syrup we manufacture contains two or three ingredients besides the pancro-pepsin. This syrup is made by dissolving the medicinal ingredients in water and adding sufficient syrup to make it permanent. The liquid is a solution of pancro-pepsin in water with sufficient glycerine to keep it from spoiling.

"Q. 6. What is pancro-pepsin?

"A. It is a medicinal substance prepared from pepsin, pancreatin, ptyalin, with lactic and hydrochloric acids and milk sugar.

"Q. 7. What is pancreatin?

"A. It is a digestive agent prepared from the pancreas of various animals, chiefly the hog; I mean by this the pancreatin of commerce.

"Q. 8. What is pepsin?

"A. Pepsin is a digestive agent made chiefly from the mucous membranes of the stomach of the hog. This is the commercial pepsin I refer to, also.

"Q. 9. State whether or not pancreatin and pepsin are well and generally known to chemists, physicians and pharmacists as medicinal agents for promoting digestion?

"A. They are.

"Q. 10. What is ptyalin?

"A. Ptyalin is a principle found in the saliva of animals, and which promotes the digestion of starchy foods. The ptyalin which we use in our pancro-pepsin, however, is not an animal product, but is known as vegetable ptyalin. It is prepared from malt, and has the same effect upon starch as the animal ptyalin has.

"Q. 11. *In your whole series of pancro-pepsin preparations, what are the predominating ingredients?*

"A. *In the powder the pancreatin and pepsin are the predominating ingredients. In the liquids the vehicle predominates. Of the medicinal ingredients of the liquids, however, the pancreatin and pepsin predominate.* In this statement, by liquids I mean all the fluid preparations.

"Q. 12. In these various fluid preparations to which you have referred, does the vehicle employed perform any function other than that of a diluent?

"A. It furnishes the medicine in a form which is preferred by some physicians in certain cases. A physician sometimes prefers to give remedies in a liquid rather than a solid form. I think it performs no other function than to give the physician the means of giving the remedy in solution instead of in powdered form, with the idea that it may be more quickly effective.

"Q. 13. *When did your company first manufacture your pancro-pepsin powder and put it upon the market under that name?*

"A. *Possibly in the year 1889.*

"Q. 14. Do I understand that you are not certain as to your recollection of this date?

"A. Yes, sir; I am certain that it was in either 1888 or 1889.

"Q. 15. What are your particular duties in connection with The Searle & Hereth Co.?

"A. I have charge of all the manufacturing.

"Q. 16. *Under what circumstances did you come to designate the powder to which you have referred as pancro-pepsin, and who suggested that name for the preparation?*

"A. *It is customary to name medicinal preparations with some title that will designate their composition or their use, or both, and it was in order that any one seeing the name should have some idea of its use that this name was given. I am quite sure that I gave the preparation this name myself. I felt certain that any physician, seeing this name, should at once know for what it was to be used, since every physician knows that pepsin and pancreatin are used in digestive disorders.*

"Q. 17. *Does what you have just said with reference to the powder apply equally to the liquid preparations of the series?*

"A. *Undoubtedly.*

"Q. 18. *Prior to the time when you suggested and adopted the name 'pancro-pepsin,' as you have testified, had you ever heard of any preparation that was upon the market of the United States under the name of 'Pancreopepsine'?*

"A. *I had never heard of any preparation at all by this name. If I had I certainly would not have adopted the name 'Pancro-Pepsin.'*

"Q. 19. *Prior to the time when you suggested and adopted the name 'Pancro-Pepsin,' as you have testified, did you know that William R. Warner, the complainant, had previously manufactured and sold a medicinal preparation which is called 'Pancreopepsine'?*

"A. *I did not.*

"Q. 20. *If you had seen a medicinal compound bearing the name 'Pancreopepsine,' what, as a chemist, would you have understood the name to signify?*

"A. *I undoubtedly would have thought that it was*

a preparation embodying the digestive agents pancreatin and pepsin.

"Q. 21. *If a medicinal compound should bear the name 'Pancreopepsine,' or 'Pancro-Pepsin,' or any like descriptive expression of the substances pancreatin and pepsin, though as a matter of fact those substances were not present in the compound, what have you to say as to whether the designation would be descriptive or not?*

"A. *Either of these names would be very misleading. My opinion is that these names given to any preparation or preparations would be intended to designate their composition, or, at least, some of the ingredients.*

"Q. 22. *You have stated that throughout the pancro-pepsin series manufactured and sold by The Searle & Hereth Company, the predominating medicinal ingredients are the pancreatin and pepsin. Please state generally the relative proportions.*

"A. *I am not sure whether the pepsin or the pancreatin predominates, but they are used in much larger proportion than all the other medicinal ingredients combined.*"

From the foregoing it will be seen that the designation "Pancro-Pepsin" was adopted as an appropriate one for the very reason that it was descriptive, and that it was adopted and originally used by the defendants without any knowledge that the complainant had registered the term "Pancreopepsine" as a trade-mark, or that there was any preparation upon the market bearing such a designation. In the cross examination on page 49 (X. Q. 37) the witness is asked whether the liquid "Pancro-Pepsin" of the defendants is not substantially the same color as the liquid "Pancreopepsine" of the complainant, and to this the witness replies that he does not know; that he is not familiar with Warner's preparation at all, and no other preparation is ever referred to in making it; *that the color is a natural one, and is not added to or detracted from.*

It is significant that no other point of resemblance between the two products is referred to anywhere in the testimony. There is not a word of testimony to the effect that the defendants have ever attempted to simulate the labels, packages or bottles of the complainant, and as before mentioned, a comparison of the complainant's and defendants' packages and labels is abundantly sufficient to explain why the record is substantially free from any charge of unfair competition, as that term is understood in law. It is true that Mr. Remick, the local agent of the complainant, says in answer to Q. 10, page 19, that the competition by the defendants has been "a very unfair one," but this is in direct answer to the question whether the competition has been a fair or unfair one, and a reading of the entire answer makes it clear that the witness had reference only to the similarity of names and to prices, and was not intending to imply that the defendants were engaged in unfair competition in the legal signification of that expression.

What Mr. Hereth says concerning the adoption of the designation "Pancro-Pepsin" for the defendants' product is fully corroborated by Mr. Gideon D. Searle, president of the Searle & Hereth Co., and who was Mr. Hereth's partner at the time the designation was originally adopted. Mr. Searle's direct examination is substantially confined to this point (Rec., pages 103-4) and is as follows:

"Q. 2. Before The Searle & Hereth Co. was organized, were you in partnership with Mr. Hereth?

"A. No, sir. We were in partnership a year before The Searle & Hereth Co. was organized. I did not understand the question at the time I answered 'No, sir.'

"Q. 3. Where were you first in partnership with Mr. Hereth? That is to say, where did you first carry on business together as partners?

"A. At Omaha, Nebraska.

"Q. 4. When did you begin business in Omaha?

"A. The 1st day of January we landed there, in 1888.

"Q. 5. When, if at all, did you and Mr. Hereth begin to manufacture any substance to which the name 'Pancro-Pepsin' was given, and to put it upon the market?

"A. It was late in the fall of '88 or early in '89.

"Q. 6. *Who gave the compound the name 'Pancro-Pepsin'?*

"A. *Mr. Hereth.*

"Q. 7. *Do you know for what reason the name was selected?*

"A. *Simply for a descriptive name for the remedy.*

"Q. 8. Was the matter of the name talked over at the time between yourself and Mr. Hereth?

"A. Yes, sir.

"Q. 9. *What, if you know, was the object of giving the remedy a descriptive name?*

"A. *It being a short name, and the name itself implying what the remedy contained.*

"Q. 10. Had you been in the drug business before you entered into partnership with Mr. Hereth? If so, where, and for how long?

"A. Yes, sir; I was five years in Fortville, Indiana, and thirteen years in Anderson, Indiana.

"Q. 11. *Prior to the time when you and Mr. Hereth adopted and put upon the market your medicinal compound under the name 'Pancro-Pepsin,' had you never heard of a medicinal compounnd which had been manufactured and put upon the market under the name of 'Pancreopepsine'?*

"A. *No, sir.*

"Q. 12. *Did you know, prior to the time of the adoption by you and Mr. Hereth of the name 'Pancro-Pepsin,' and the putting of the compounnd on the market under that name, that William R. Warner, of Philadelphia, had manufactured and put upon the market a medicinal compounnd under the name of 'Liquid Pancreopepsine'?*

"A. *No, sir.*

"Q. 13. During the whole time that you were in the retail drug business in Fortville, Indiana, and Anderson, Indiana, were you accustomed to sell patented medicines and proprietary remedies?

"A. Yes, sir.

"Q. 14. Were physicians' prescriptions filled in your drug stores?

"A. Yes, sir.

"Q. 15. I understand, from one of your previous answers, that you had a retail drug store in Anderson, Indiana, from about 1875 onward. Is that correct?

"A. From 1874 to 1887.

"Q. 16. During the whole of that period, did you know of any physician's prescription which called for a substance called 'Pancreopepsine' or 'Liquid Pancreopepsine'?

"A. No, sir."

The cross examination of this witness extends from page 104 to page 109, but it in no way affects the statements above quoted.

We submit that no one can read the testimony of Mr. Hereth or that of Mr. Searle without being impressed with the spirit of fairness that has been manifested by them from beginning to end of this controversy. They do not wish to interfere with Mr. Warner, still less to wrong him. Mr. Hereth says frankly that if, at the time they adopted the name "Pancro-Pepsin," they had known that Mr. Warner was putting upon the market a preparation which he designated "Pancreopepsine," they would have refrained from using the name; but this was not on account of any legal right which they conceded to Mr. Warner in the descriptive expression. In fact, when Mr. Warner complained they offered to make every reasonable concession, and an adjustment might have been reached if Mr. Warner had not asked too much. What Mr. Hereth says on this subject is in an-

swer to X. Qs. 65 and 66 on page 52, and in answer to R. D. Q. 95, page 56, as follows, the italics being ours:

"X. Q. 65. Did Mr. Warner, or some one representing him, ever notify you that your use of the name was damaging to him, and ask you to desist?

"A. Mr. Warner has had a representative call upon us several times and request us to discontinue the use of the name, but I do not remember any statement made by the representative that it was causing him any financial injury.

"X. Q. 66. He charged that you committed a wrong in imitating his name, or rather the name of his medicine, did he not?

"A. He made this claim, but we told him that we regarded the name as purely descriptive of the composition and use of the remedy. I told Mr. Warner's representative that the preparation we originally made, that is, the powder, was so different from his preparation that we thought he could have no claim against us. *I afterward stated to him, and at one time to Mr. William R. Warner personally, in Philadelphia, that out of courtesy we would gladly discontinue making the liquid pancro-pepsin, but not because we thought he had any right to the name.* I believe Mr. Warner and his representative both, at different times, stated that this would not be satisfactory, so we dropped the matter without taking any action. This is to the best of my recollection.

* * * * *

"R. D. Q. 95. You have stated in your cross examination that you offered, out of courtesy to William R. Warner, to withdraw your liquid pancro-pepsin from the series, although you felt that you had a perfect right to use the designation. Please state more fully, if you can recall them, the circumstances connected with this offer on your part.

"A. I do not remember certainly whether I first made this offer to Mr. Warner personally or through

his representative. We have always had a high regard for Mr. Warner, and decided, if possible, to settle the matter amicably, especially since we feel that manufacturing pharmacists should be upon friendly terms with each other. We thought that this was as much of a concession as we ought to make. Had Mr. Warner's name for his preparation been an arbitrary one we would have dropped the name we selected. We have had what might be considered parallel cases submitted to us, and took the action our competitor requested."

Certainly the defendants were willing to concede as much as any one could possibly expect with reference to a designation which, to their minds, was simply descriptive, and which they had selected and adopted for that very reason. The designation "Pancro-Pepsin" is one of the most obvious ones that any one could select who wished to signify that the article to which it was applied was a remedy for indigestion, composed wholly or in part of the well-known digestive agents pancreatin and pepsin. If anything more could be required to make this perfectly obvious it is to be found in the deposition of James Turner, Rec. pages 110-16. It appears from this deposition that Mr. Turner was in the slaughtering and packing business in Chicago in the year 1878, and in the course of his business manufactured both pancreatin and pepsin. A Mr. Joseph Dell, of the firm of Dell & Clark, druggists in this city, wished to put upon the market a remedy for indigestion composed principally of pancreatin and pepsin, and Mr. Turner was interested in the subject because he was to furnish the ingredients from his packing establishment. On page 111 a letter is reproduced, the original being an exhibit in the case, wherein Mr. Turner suggests that they call the substance Pancro-Pepsin or Pancro-Peptin. The name Pancro-Pepsin was adopted, and labels were printed with the designation, but for reasons ex-

plained by Mr. Turner the business never progressed to any material extent. One of the labels is an exhibit in the case, having been offered in evidence on page 113 of the record. The purpose of introducing this testimony as to the proceedings of Mr. Turner and Messrs. Dell and Clark is not to set up an earlier use of the term than that claimed in behalf of the complainant, but to show how natural it is for any one seeking an appropriate descriptive designation of the compound to choose the form, or substantially the form, employed by the defendants. When Mr. Turner suggested the name he was seeking only a euphonious descriptive term, as is shown by his testimony on page 112, as follows:

> "Q. 11. At the time you suggested to Mr. Dell in the letter which has been produced, the name 'Pancro-Peptin' or '-Pepsin' had you ever known the name to have been employed by any one else?
>
> "A. I had not.
>
> "Q. 12. For what reason did you suggest the use of that particular name?
>
> "A. It was to express the nature of the ingredients I was making; I wanted to call it, as near as I could, by its proper name, the combination of the two.
>
> "Q. 13. What were the ingredients that you wanted to express by means of the name?
>
> "A. Pancreatin and pepsin."

Mr. Turner then goes on to say that they had bottles made and labels printed, but that the firm of Dell & Clark got into financial difficulties and the matter progressed no further.

Subsequently Mr. Turner was recalled and testified (p. 116) that at the time he suggested the name and had the labels printed he had never heard of the complainant or the name "pancreopepsine." His testimony is as follows:

> "Q. 1. At the time you wrote the letter which has been offered in evidence, and had the labels printed, a specimen of which has been offered in evidence, did

you know or had you heard that William R. Warner or William R. Warner & Company, of Philadelphia, were putting upon the market a medicinal compound which was called 'Pancreopepsine'?

"A. I never heard of that name.

"Q. 2. At the time referred to, had you ever heard or did you know that William R. Warner or William R. Warner & Company of Philadelphia, or any one else, had ever put upon the market a medicinal compound called 'Pancreopepsine' or 'Liquid Pancreopepsine'?

"A. Never heard of any one. Never heard the name."

We respectfully request that the court will give careful consideration to the deposition of Prof. Walter S. Haines, since, as a whole, it is a fair, intelligent and scholarly presentation of the defendants' position. As has before been pointed out, Prof. Haines takes the ground that the designations "Pancreopepsine" and "Pancro-Pepsin" are essentially descriptive in their character, and that to any chemist, pharmacist or physician they must inevitably convey the intelligence that the compound to which they are applied is composed wholly or largely of pancreatin and pepsin, and that the compound is for use in digestive disorders. In the face of such a showing it seems impossible that the court can hold that the complainant has a legitimate trade-mark. If the complainant can be held to have a trade-mark in this name, then every dealer adopting an expression intended to be merely descriptive, for application to his particular wares, is placed in peril, since some one else who has previously adopted it, or some name similar to it, because equally descriptive, may claim prior right to it as a trade-mark. It is this very injustice that the law aims to guard against, as is clear from many of the decisions above quoted.

The complainant produced in all eight witnesses—seven on the *prima facie* showing and one, Dr. Virgil Coblentz, in

the rebuttal. Of these Mr. Benson, a Chicago druggist, testified as to the filling of a certain prescription by one Dr. Bate, who appears to have written several such prescriptions at the instance of Mr. Remick, but who, aside from this, is industriously kept in the background. Two other Chicago druggists, Messrs. Thorburn and Stolze, testified that the names "Pancreopepsine" and "Pancro-Pepsin" are so nearly alike as to be liable, in their opinion, to cause confusion in placing stock upon the shelves and filling prescriptions. Three witnesses, William R. Warner, the complainant, Irene Haffa, a clerk in his employ, and Frank M. Ramsey, manager for William R. Warner & Company, testified concerning the adoption and registration by the complainant of the alleged trade-mark "Pancreopepsine," and the marketing of medicinal preparations under that name. The two most aggressive witnesses for the complainant are Mr. Remick, manager of the Chicago branch of William R. Warner & Co. and Dr. Virgil Coblentz, the complainant's expert, employed to oppose the testimony of Prof. Haines. Mr. Remick has assumed the attitude of sponsor for the complainant in this litigation, and it is he who has said that the defendants have been guilty of unfair competition, his grounds for this assertion being contained in his answer to Q. 10, p. 19, before referred to. On page 21 Mr. Remick takes the ground that "Pancreopepsine" is a "coined term," because, to use his language, "Pancreo means nothing; it may refer to drugs " or it may refer to parts of the human body. The origina- " tor's intention I could not say. Pancreo might be derived " from a great many different names, but as used here it is " certainly a fanciful term, for it means nothing." In answer to Q. 22 on the same page, in which he is asked to what part of the human body he refers in the last answer, he replies, " To the pancreatic glands. *All words of every preparation*

" can be traced through the Greek or Latin languages to " some particular word that is entirely different in sound."

The schoolmaster is abroad!

Some more of Mr. Remick's views are to be found on pages 24 and 25 of the record, as follows, the italics being ours; and his testimony is quoted this time for the enlightenment of the Court, since Mr. Remick is no doubt a much better authority on the tricks of the trade than he is on etymology and English grammar:

"X. Q. 59. What would you understand as to ingredients from the name 'bromo camphor'?

"A. *At the present day there is very little dependence to be placed upon the name. For instance, a preparation on the market called 'Bromo Pepsin' contains no pepsin, 'Bromo Celery' contains no celery, except for flavoring. 'Bromo Kola' contains no kola, except for flavoring. 'Syrup of Figs,' it has been decided that there is no figs in them. So unless a person knows the working formula, they can only surmise as to the ingredients. Celery is known as a nerve tonic, therefore it is chosen as a name for Bromo Celery. Pepsin is used for digestion, therefore they chose the name Bromo Pepsin. Figs is known as a laxative; that is why they choose that name to represent a laxative compound. Many other cases might be mentioned. So, in these days names imply very little, except for an advertisement.*

"X. Q. 60. Leaving out the element of deception, what do you understand by the designation bromo-camphor?

"A. From a pharmacist's point of view, nothing.

"X. Q. 61. Please explain what you mean by your expression, 'a pharmacist's point of view.'

"A. One who has experience in pharmacy at the present day.

"X. Q. 62. *Would you not understand that if the term was not deceptive it implied that bromine and camphor entered into the compound as ingredients?*

"A. *I suppose so.*

"X. Q. 63. In other words, though the term bromo-camphor is not literally descriptive, it is highly suggestive, is it not?

"A. *Not at the present time, when we have Bromo Corn Cures, Bromo Chewing Gum;* and I would be safe in saying 500 other different bromos on the market today. Bromo is supposed to have been a coined word, and has never been decided otherwise, to the best of my knowledge.

"X. Q. 64. *Does your last answer revive the element of deception?*

"A. *Yes.*"

It was Mr. Remick, it will be remembered, who caused the six decoy prescriptions to be written and who gave them to his friends to have them filled. Only two of the six produced the results which were desired, so far as the testimony shows. Mr. Remick is zealous in behalf of his employer to the verge of recklessness, as will be seen from the following, forming the closing part of his cross examination, on pages 26 and 27, the italics being ours:

"X. Q. 72. You say in answer to question 11 of your direct examination that doctors were constantly confused by the similarity of name between the Pancreopepsine of the complainant and the Pancro-Pepsin of the defendants. On what do you base this assertion?

"A. As stated in the previous answer, on a similarity of name, the two being very similar in spelling, phraseology and sound.

"X. Q. 73. It is quite obvious that you did not understand the question. I request the notary to read it over and if it is not perfectly clear to you I will endeavor to make it so.

"Question re-read.

"A. By my personal experience with them.

"X. Q. 74. Please give an instance in detail, with the name of the physician.

"A. I am unable to recall this at the present time, as I have been off the road for about six years, but I used to see a great many of these imitations put in upon prescriptions for this *and other preparations of ours.*

"X. Q. 75. Can you recall any particular instance, with the name of the druggist, aside from those which you have already mentioned as having grown out of the six prescriptions which you had specially prepared, wherein a druggist has furnished the liquid Pancro-Pepsin of the defendants by mistake, when the liquid Pancreopepsine of the complainant was prescribed?

"A. Not just at this moment. I will state that it was not always the liquid Pancro-Pepsin was given. Sometimes what was called Elixir Pancro-Pepsin was substituted.

"X. Q. 76. Can you give any special instance of the substitution of Elixir Pancro-Pepsin for the complainant's product in the manner defined in the last question?

"A. *No, except a part of the original six mentioned above.*

"X. Q. 77. You mean a part of the six prescriptions which you had specially prepared; is that correct?

"A. Yes."

Dr. Coblentz, when called in the rebuttal, does not adopt Mr. Remick's peculiar philological ideas, and does not fall in with his theory that the prefix "pancreo" might refer to the pancreatic glands of the human body; but he takes the ground that the term "pancreopepsine" is non-descriptive for the reason that pancreatin is a term which has no definite signification in chemistry or pharmacy. He admits that there is a substance extensively manufactured, and which is sold in all drug stores, that goes by the name of pancreatin, but he characterizes it throughout his deposition as "commercial pancreatin," says that it is very variable in its chemical composition, and says also, with great emphasis, that the name is not recognized by chemists. *It is to be noted, how-*

ever, that Mr. Warner, the original complainant, appears to have known what it is, because he names it as one of the ingredients of "Pancreopepsine" (p. 35, X. Q. 22). A review of Dr. Coblentz's cross examination will show that he was questioned until he had made the foregoing assertions so clearly and positively that there was no possible way left for him to retreat from them or qualify them; *and then a book entitled "Hand Book of Pharmacy," of which he is the author, was brought to his notice, wherein he refers to pancreatin as if it were a substance so well known and so well understood as to require no explanation.* In this connection the attention of the court is particularly directed to so much of Dr. Coblentz's cross-examination as extends from X. Q. 186, page 149, to and including the answer to X. Q. 200, page 152, which we reproduce as follows:

"X. Q. 186. What do you understand by the name pancreatin?

"(Question objected to as having been answered time and again in the course of this examination, both in the direct examination, in answer 11 and particularly the last part of the same, and also in the cross examination more than once.)

"A. I have explained what I understand of the name pancreatin, I think, in very clear terms several times during the direct and cross examination.

"X. Q. 187. In other words, when you use the word pancreatin, if you ever do use it, what do you mean by it?

"A. As I have already cited several times, the word pancreatin is unknown to physiological chemists, hence speaking from a standpoint of a chemist, I do not recognize the word. Speaking from a commercial point, I have already explained the various meanings applied to this word.

"X. Q. 188. You have just stated off the record that you have found an additional specimen in the college labeled pancreatin, and have brought it to the

examination room. Please state whose preparation it purports to be.

"A. Armour & Co.'s pancreatin.

"X. Q. 189. Is the name pancreatin recognized in pharmaceutical chemistry?

"A. In some text-books upon pharmaceutical chemistry we find the title pancreatin. For example, one of these which I cited in the direct examination states that it is a synonym for trypsin. In other text-books the title does not appear.

"X. Q. 190. I have read over your deposition given thus far, and I think I have read it understandingly, but I am unable to determine from your answers whether the name pancreatin is one which you recognize or use professionally, or, if you do use it, in what sense you use it. Can you clear this up?

"Mr. Brown: This question has been repeated in other forms a half-dozen times, and the answers have been perfectly uniform, commencing with answer 11 in direct examination, if I remember the number correctly, and I think I do, and therefore the repetition is simply a waste of time, and an effort to produce uncertainty by the questions rather than the answers, and therefore improper. Still the witness is requested to continue in the patience he has before exhibited, and answer the question again.

"A. As already explained several times in my deposition and cross-examination, I desire once more to state that the word 'pancreatin' or 'commercial pancreatin,' which I also employed, is absolutely unknown to and unrecognized by scientific chemists. I called attention to the fact that the word pancreatin never occurs in either standard works on physiological chemistry or in its literature. The word is used commercially indiscriminately for preparations containing either trypsin, steapsin or amylopsin, or a mixture containing two, or sometimes for a mixture containing the three. A manufacturer has a perfect right to label a preparation containing any one or two or all three of these ferments pancreatin. For I have shown that the

word has been applied indiscriminately to a number of mixtures.

"My experience in the examination of the so-called commercial pancreatins from time to time through a number of years bears out the above views, as well as a search of the literature and conversations which I have had with manufacturers of this product.

"X. Q. 191. Is not every specimen of pancreatin, if unadulterated, a preparation made from the pancreatic gland?

"A. It is to be hoped that the various manufacturers prepare their so-called pancreatins from the pancreatic gland. Since they do not publish their methods of preparation we must necessarily accept their statements. Once before in this cross examination I called attention to the fact that I have found specimens which I stated that it seemed to me as though they were prepared from anything else except the pancreatic gland. Of course such cases occur very rarely.

"X. Q. 192. In the course of your cross examination you produced and referred to a publication of which you are the author. I would like to have you produce that book again, if you please.

"A. I herewith produce a copy of the book.

"X. Q. 193. Is the book which you have just produced in all respects identical with the one produced yesterday?

"A. It is, with the exception that some new chapters on urine analysis and microscopy, etc., were added in the later edition.

"X. Q. 194. Do you find the word pancreatin used in this hand-book of pharmacy of which you are the author?

"A. In the index I find the reference 'Pancreatin Emulsion.' This refers to the uses of pancreatin to which it is sometimes applied in preparing emulsions.

"X. Q. 195. The index refers to page 300 of the volume, and on that page I find a paragraph which I quote as follows:

" '*Pancreatin.* A mixture of natural ferments; forms an excellent emulsifying agent when employed in an alkaline medium (as sodium bi-carbonate). The emulsions obtained by means of it are rarely permanent, but are often preferred, because of their easy assimilation, for the administration of such fats as cod liver oil to consumptives. Pancreatin is often added to emulsions to assist the thorough emulsification of the fats or oils. It should be mixed with an equal bulk of sodium bi-carbonate and dissolved in a small quantity of water; to this is then added the oil or emulsion gradually, the mixture being well shaken after each addition.' "

"Please state whether the foregoing is a correct transcript from page 300 of your work, 'Hand-Book of Pharmacy,' published in the year 1894?

"A. It is.

"X. Q. 196. *To what did you refer by the name 'pancreatin' in the foregoing quotation?*

"(Question objected to as immaterial, irrelevant, and because, as stated by the witness in the preceding answer, 'Pancreatin Emulsion' was being described.)

"A. As the index shows, as well as chapter under which it is included, it is referred to simply as one of many emulsifying agents.

"X. Q. 197. What substance did you refer to when you used the name pancreatin in the paragraph above quoted?

"(Same objections.)

"A. The paragraphs already cited explain themselves. It was not the purpose of this book in detailing methods for preparing emulsions to explain all points concerning the composition of so-called pancreatin, so that a short general statement was made in saying that it was merely a mixture of natural ferments, not specifying what might be present or absent.

"X. Q. 198. 'Pancreatin' as used in the above quotation is a noun, and hence the name of some object. Will you not state the object that you intended to name by the term 'pancreatin' in that paragraph?

"A. *It referred to pancreatin in a general commercial way.*

"X. Q. 199. Then I understand that it meant what you now call 'commercial pancreatin.' Is that correct?

"A. As used in this connection, as employed in my text-book, I call attention to its uses as an emulsifying agent, it not being the purpose of the book to go into details concerning all the possibilities of the question commercial pancreatin. Understand distinctly that I call attention to its use in this book simply as an emulsifying agent and nothing else.

"X. Q. 200. You seem to have misunderstood my question, Dr. Coblentz, and I will therefore try to make it clear. By the term 'pancreatin' in the above quotation, did you refer to the substance which you now designate commercial pancreatin, as to which you have said in a former portion of your deposition you have frequently made tests for determining their emulsifying powers?

"A. In the above article I simply called attention to the general use among pharmacists of what they buy under the name pancreatin as an emulsifying agent. In my lectures, in which I go into greater details, I always call attention of the students to the fact that this agent occasionally fails to emulsify and frequently specify that they should use some particular brand, requesting them when selecting a specimen to read the label and ascertain if it states thereon that the product is capable of emulsifying fats and oils."

The foregoing excerpt from Dr. Coblentz's deposition is sufficient, we think, to convince any one of the utter nonsense of the position assumed by him in this case.

Thanks to Mr. Remick and Dr. Coblentz, the complainant's record has been so far enlivened as to be *serio-comic*.

In other portions of his testimony Dr. Coblentz attempts, under the guidance of questions by complainant's counsel, to show that the prefix "pancreo" might refer to certain an-

cient and recondite or obsolete terms, and that therefore the designation is not necessarily descriptive. As a matter of fact there is no one of the ancient or obsolete terms referred to from which the prefix could be logically derived, but even if there were, no pharmacist and no physician could possibly have any other understanding from the expression "Pancreopepsine" than that it was intended to signify the presence of the two well-known substances pancreatin and pepsin. Of course, the same applies to the term "Pancro-Pepsin" of the defendants, and they, at least, are candid enough to say that it was for this very reason that the name was adopted.

It is not shown that the terms "Pancreopepsine" and "Pancro-Pepsin" ever served any purpose except to distinguish the article from articles of other composition, rather than the complainant from other manufacturers of the article. But if purchasers did assume that articles of similar composition were of the same origin, this would not entitle complainant to the exclusive use of this name, though it might be a reason why others should accompany the name of the article with the name of the maker. This the defendants have always done, and all who wished complainant's product had only to observe the name of the manufacturer.

No Infringement.

No charge of infringement can be founded upon the fact that the defendants have used in connection with the product whose distinguishing components are pancreatin and pepsin the two words, or any abbreviation of the two words which signify their presence, for the defendants are as much entitled as the complainant to any advantage which the use of these descriptive terms affords in marketing the article. If by forming a single word of five syllables, using the older

style of spelling the word pepsin, with an "e" at the end, and running it continuously into the three-syllable word preceding, the complainant is to distinguish his mark from the descriptive terms of which it is composed, the distinction can not avail him for the purpose of appropriating other marks whose resemblance is due merely to their derivation from the same descriptive terms, for this would be equivalent to allowing the complainant practically to appropriate the descriptive terms themselves. If such trivial changes were to be treated as the subject of protection, they could confer no exclusive right beyond the specific modification, consisting in coalescing these two words into one continuous word of five or six syllables. Defendant's mark uses the well known word "pepsin" without change and abbreviates the equally well known word "pancreatin" into a word of two syllables, preserving the identity of each word and separating them by a hyphen. It is as clearly distinguished from the mark of complainant, both in its appearance to the eye and in its sound to the ear, as any designation of this article utilizing the names of the distinguishing ingredients can well be. If the consecutive word of five syllables used by complainant is to be distinguished from the descriptive terms of which it is composed (as it must be to escape impeachment as a descriptive term), it must be strictly limited to the precise changes which complainant has made, and can not cover other uses of the same descriptive words to identify the same ingredients, where the resemblance is due to the preservation of the descriptive significance of the well-known words equally identifying the composition of the respective parties. If the defendants had, instead of using a common abbreviation of the first word, in connection with the unmodified word "pepsin," used the entire word "pancreatin" as well as the entire word "pepsin," thus, "Pancreatinpepsin," it would have been more readily con-

fused with complainant's mark than what defendants now use. If they had used the two entire words separately, either with or without the hyphen between them, it would have been quite as readily confounded with complainant's as the abbreviation which they have employed. If the departure of complainant from the literal writing of the descriptive terms is so slight that any other use of these descriptive terms is liable to be confounded with it, this is no reason why such slight departure should secure to complainant practically the exclusive control of the use of these terms in connection with articles composed of these ingredients. If, on the other hand, complainant were to be protected in the specific change which he has made from the separate writing or usual spelling of these words, the protection, if any, can go no further, and defendants have not copied this. They have simply done what every manufacturer of a compound of these ingredients was entitled to do—applied to the packages containing a remedy whose distinguishing features were pancreatin and pepsin, a term which concisely and honestly informs the public that these desired remedial agents enter into the composition of the contents of the package, the term "liquid" or the term "powder," or other appropriate term, being used to distinguish the different forms in which the preparation is offered for sale. In this there is no infringement upon any right that has been acquired or could be acquired by this complainant, but merely the exercise of a right which is common to all manufacturers of articles thus composed.

This suit represents an effort by the complainant to convert into an exclusive trade-mark descriptive terms originally adopted as the name of the article and obviously selected for the purpose of imparting information concerning its composition and qualities. These terms have always

been used to distinguish articles of this composition from articles of a different composition, whether made by this manufacturer or by different manufacturers. Their office has never been to distinguish the manufacturer of the article from other authors or manufacturers of a similar article, but solely to distinguish an article of this composition. The name and place of business of the manufacturer has been used to indicate the origin of the article just as conspicuously and as universally as the descriptive term has been used to designate the article. Nobody who was particular to obtain an article of complainant's manufacture rather than a composition of pancreatin and pepsin would depend upon the descriptive term for the source of manufacture when clearly informed on the same label in unmistakable terms by whom the article was manufactured and where it was made. Nor can complainant, when using such a descriptive term to designate the article, be protected against competition in its manufacture and sale by obtaining an exclusive right to terms which convey information concerning its composition and purposes which others have the same occasion to use for the purpose of conveying similar information concerning articles which they have the right to manufacture.

There is absolutely no evidence to support the charge of fraud or unfair competition, and the court below so held. Defendants have used every precaution to indicate upon their labels the origin of the goods marketed by them by informing purchasers who manufacture them and where they were manufactured. There is no circumstance justifying the inference that defendants have ever sought to pass off their goods as of complainant's manufacture, or that anybody has been deceived concerning the manufacture. When complainant adopted such a descriptive term he took

as one of the consequences the hazard of competition with others selling a similar article under similar descriptive terms, since he had no right to pre-empt the terms. He can not disturb defendants' right in the use of such terms simply because purchasers who purchase without reference to the maker of the goods, but with primary reference to the composition or medicinal purpose, pay no attention to the name of the manufacturer. This is one of the incidents of the sale of an article under a descriptive name as distinterms, since he had no right to preëmpt the terms. He can guished from a purely arbitrary one.

Defendants have done only what they and all other manufacturers of articles composed of these familiar remedial agents have the right to do in applying to them suitable descriptive terms by which dealers and consumers are informed concerning their composition and properties. The information conveyed is as true of defendants' product as it is of complainant's, and defendants have the same right as complainant to convey this information through terms familiar commercially as signifying the presence of the desired ingredients.

Fair competition requires that defendants have the same freedom as complainant in the use of descriptive terms necessary or convenient to designate the contents and uses of the packages produced and marketed by them. It follows that the decision of the Circuit Court of Appeals was right and should be affirmed in the event that this court entertains jurisdiction of the appeal.

Respectfully submitted,

PHILIP C. DYRENFORTH,
Of Counsel for Defendants.

CHICAGO, September, 1903.